Supreme Court

OF THE UNITED STATES.

No. 65.

CARHART & NEEDHAM,

Appellants,

against

CHARLES AUSTIN,

Appellee.

Brief on the part of Appellants,

By C. M. KELLER, [redacted]

NEW YORK:
ANSON HERRICK & SONS, LAW PRINTERS, 16 SPRUCE STREET.
1868.

Supreme Court of the United States. 1

CARHART & NEEDHAM,
Appellants,

vs.

CHARLES AUSTIN,
Appellee.

2

BRIEF ON THE PART OF APPELLANTS.

The important legal questions involved in this case are: 3

First. Whether the second and third claims of the patent re-issued August 18th, 1857 (Record, pp. 6 to 11) were legally introduced in view of the fact that the subject-matter of those claims is not found in the original patent or the record thereof, it being proved by evidence *dehors* the record that they were parts of the invention completed before, and intended to be secured by, the grant of the 4 original patent, but omitted by inadvertence and mistake.

Second. If the foregoing shall be decided in the negative, whether in the absence of proof of fraud in the introduction of the second and third claims, the patent is void as to the first claim, the subject matter of which is found in the original patent.

5 The facts bearing on the legal questions above stated are fully discussed in the brief of my learned associate, and are in substance as follows, viz.:

The subject matter of the first claim is, so connecting the board which contains the reed seats, or perforations for the reeds, and termed the reed-board, with the exhaust bellows, that it shall form substantially a part of the stationary leaf or cover of the exhaust chamber thereof,
6 while the exhausting or pumping chamber is placed in immediate connection with the said exhaust-chamber, without intervention of tubes, thus improving the tone of the reeds and expediting their speaking, and giving a compact, light, and graceful form to the instrument.

Everything to which this claim relates, in every particular, is described and represented in the original patent granted on the 28th of December, 1846.

The subject matter of the second claim is for combining
7 with the reed seats, cells which extend over each reed so that the inward currents of air, induced by the exhausting bellows, shall pass through the cells from the heel or fastened end of the reeds, and from the cells by the free end of the reeds into the exhaust chamber of the bellows. The obvious purpose of the organization covered by the first claim is to so exhaust the chamber of which the reed board constitutes the top, that the inward currents from the under side of the reeds shall be direct instead of oblique. And the object of the subject matter of the second claim
8 is to have the currents of air approach and pass the edges of the vibrating end of the reeds at right angles to the planes of the reeds. The subject matter of the second claim would be useless without the subject matter of the first claim, but the subject matter of the first claim is useful without the subject matter of the second claim.

The subject matter of the third claim is for combining with the reed cells and reed seats a concentrating chamber formed by placing a vertical board on the sound board a short distance back of the open ends of the reed cells. As the open ends of the cells are toward the back of the instrument, and much of the sound would be lost within the

instrument, by the placing of that board to form the cham- 9
ber, the sounds from all the reed cells are discharged into and concentrated in this chamber and together reverberated into the room.

The subject matter of the second and third claims are not found either in the description or drawings of the original patent, or in the model on which that patent was granted, and which remained in the Patent Office.

But when Carhart, the patentee, went to Washington to make application for the original patent, he took with him from Buffalo a complete instrument and a small one repre- 10
senting only the bellows arrangement. Both of these he presented at the Patent Office. The complete instrument contained everything which is found in the re-issued patents, the reed cells, and the concentrating chamber, as covered by the second and third claims, as well as the arrangement of the bellows covered by the first claim. And all these features of his said invention Carhart fully explained to Mr. Knowles, then in charge of the model department of the Patent Office. The small model represented only the subject matter of the first claim, but not of 11
the second and third claims. The machinist of the Patent Office informed Carhart that the complete instrument containing all his improvements was too large, and could not be received by the Office. And with that generosity and improvidence which often characterizes men of genius, he presented it to Knowles, the machinist, and proceeded to take his patent with the remaining model.

That he intended to patent all he had invented is proved 12
by himself, and by the fact that he went to the trouble and expense of taking a complete instrument, with all his improvements, to Washington, and to the Patent Office. That identical instrument, so taken to the Patent Office at the time he went to Washington to apply for the original patent, and which could not be received on account of its size, was finally traced from Knowles, through several persons, to the Rev. James B. Donelan, in whose possession it was found in the same condition as when Carhart presented it to Knowles. And it was put in evidence before

the Commissioner of Patents, on the application for the re-issue, with the chain of evidence as complete as it now appears before this Court. No facts ever have, or ever can be more completely established by proof than those above stated.

The re-issue in question was not granted lightly, either as to the facts or the law. It was passed upon by an eminent jurist, Judge Mason, then Commissioner of Patents, on proof such as I have above stated, and after hearing arguments for and against. Most re-issues have been granted on *ex parte* motions, and many of them so loosely as to bring that beneficent provision of the statue into reproach.

In many instances patents granted for inventions so defective or incomplete that they could not be reduced to successful practice, and which have remained for years in the archives as dead letters, have been drawn out of their long slumber, revivified and re-issued with claims to compel the payment of tribute by subsequent inventors of valuable and successful improvements. It is to be feared that looseness in the practice of granting re-issues has induced a deep prejudice against the provision of a law than which none more just and beneficent ever graced a book of statutes. It was enacted to put in statute form the ruling of this Court, in Grant *vs.* Raymond (6 Peters, 242), in which it was held that a patentee, at common law, had a right to amend all errors of inadvertence by the surrender and re-issue of the defective patent, for the unexpired term. The opinion of Chief Justice Marshall in that case is the most conclusive and clear vindication of the wisdom and justice of such a provision of law, which can be produced.

In view of the uncontradicted facts found in the record, we beg to discuss, in their regular order, the two legal questions before stated.

I. 17

Whether the second and third claims of the re-issue were legally introduced, in view of the admitted fact that the subject matter of these claims is not found in the original patent or the record thereof, it being proved by evidence, dehors the record, that they were parts of the invention of the patentee, completed before, and intended to be secured by the grant of the original patent, but omitted by inadvertence and mistake. 18

The substance of the decision of the learned Court below is that defects in patents can be amended by re-issue, under the provisions of the thirteenth section of the Patent act of 1836, so long as the re-issue is limited to what clearly appears from the specification, drawings or model of the original patent, but that when a patent is defective by reason of the patentee having, by inadvertence or mistake, omitted to describe or represent some material part of his invention, the patent cannot be amended by re-issue. That the thirteenth section of the Patent act of 1836, according to its legal con- 19
struction, authorizes the re-issue of defective patents only when the defect is proved by the patent itself, or the record of the application on which it was granted; but that it does not authorize re issues when evidence, *dehors* the record, is necessary to establish the defect in the original patent, or the nature of the defect. There is nothing said in the opinion as to the manner of proof to establish the fact that the defect in the patent was the result of inadvertence, accident or mistake. That, at least must come from 20
dehors the record. With great respect, we submit that given by the Court below is not the true legal construction of that act.

In substance this act was simply putting in statutory form the legal right which, according to the ruling of this Court in Grant *vs.* Raymond, before cited, every patentee possessed at common law.

The decision in Grant *vs.* Raymond does not draw nice distinctions between different kinds of defects, but goes

upon the broad ground of any and all defects arising from inadvertence, accident or mistake, and which might render the patent inoperative or invalid.

In England it has been held by the Chancellors that a defective patent could not be amended by re-issue; but it was so held because patents at that time were granted on the title of the invention, and the grant was made on the express condition that a full and complete description of the invention should be enrolled within six months. But the Chancellor intimated that a defective patent might be cancelled, and that when called it would be no bar to the grant of another and valid patent to the same party for the same invention, which, in fact, amounts to the same thing.

The first enactment of Congress regulating the re-issue of defective patents, is found in the third section of the act approved July 3, 1832. The third section of the act of 1793, then in force, specified the prerequisites to a valid grant; and the third section of the act of 1832 authorized the re-issue "whenever any patent shall be invalid and inoperative by reason that any of the terms or conditions prescribed in the third section of the act of 1793, have not, by inadvertence, accident or mistake, and without any fraudulent intention, been complied with."

The thirteenth section of the Act of 1839 contains in substance the same provisions, stating "that whenever letters patent shall be *inoperative*, or *invalid*, by reason of a *defective* or *insufficient description* or *specification*, or by reason of the patentee *claiming* in his *specification* as his own invention *more than* he had or shall have a right to claim as new:" the error having arisen by inadvertency, accident, or mistake, on surrender the Commissioner may cause a new patent to be issued to the said inventor for the same invention for the residue of the period, in accordance with the amended specification and description.

The terms *description* and *specification* as used in this act are not convertible terms, the one (description) relates to the construction, and is addressed to the artisan or expert, while the other (specification) relates to what distin-

guishes the invention from all other things before known and what is claimed as new.

Act of July 4th, 1836, §§ 5, 6, 7, 8, 12, 13, 15. Act of March 3, 1837, §§ 1, 3, 7, 8, 9.

These two enactments, like the ruling of the Supreme Court in Grant *vs.* Raymond, draw no distinction between the kind of defects which may be cured by re-issue and such as cannot. Nor do either indicate or specify the kind of proof which may be admitted to prove that what might be claimed in the re-issue is the same invention intended to have been patented by the original patent. All that is required is that the patent shall be inoperative or invalid by reason of some defect resulting from inadvertence, accident, or mistake, and without fraudulent or deceptive intention; and that the re-issued or amended patent shall not be for a different or subsequent invention, but that it shall be restricted to the same invention which the patentee intended to secure at the time of applying for the original patent, and that it shall be limited to the unexpired term of the original grant.

This remedy is provided for either of two consequences: *First*, when the patent is either inoperative, that is, when the specification of claim fails to cover or give legal effect, in whole or in part, to the invention intended to have been patented, by reason of a defective or insufficient specification of claim; or, *second*, when it is invalid and cannot be enforced at law by reason of a defective or insufficient description, or by reason of the patentee claiming more than he had a right to claim.

A patent may be inoperative to secure the invention actually made and intended to have been patented, and yet not be invalid.

A patent, without any specification of claim, but with a sufficient description of a new and useful invention, would not be invalid, and yet it would be wholly inoperative to secure the invention, for in that condition no court could give it legal effect against an infringer.

The patentee, in such a case, would be in the condition

of having fulfilled his part of the contract without a consideration, by reason of having failed to specify the extent and limits of the demand for the patent. But a patent can only be invalid by reason of the patentee having failed to give the consideration for the grant; that is, when the invention is not new or useful, or when he has given a defective or insufficient description of the invention, or when he has exceeded his right by claiming more than he had a right to claim.

The latter defect would invalidate the grant, and to avoid this the thirteenth section of the act of 1836 provides the remedy by the surrender of the original, and grant of an amended patent.

But this act would be inconsistent and unjust if it provided a remedy for amending the contract when the public have failed to receive a sufficient consideration, or have granted too much, and not when the patentee has failed to secure what he was justly entitled to. And, therefore, the act justly and considerately provides the same remedy, "whenever the patent shall be inoperative by reason of a defective or insufficient specification of claim," that it does when it is invalid by reason of a defective or insufficient description, or when the patentee claims more than he invented. (Stimpson *vs.* Westchester Railroad Company, 4 Howard, 380, 401; O'Reilly *vs.* Morse, 15 Howard, 62, 111, 112; Goodyear *vs.* Day, decided by Mr. Justice Grier United States Circuit Court, District of New Jersey, September Term, 1852; French *et al. vs.* Rogers *et al.*, 1 Fisher, 133; Elisha Bloomer *vs.* McQueeran *et al.*, Harding's Reports, 495; Sloat *vs.* Spring *et al.*, Harding's Reports, 369, 376; Woodworth *vs.* Stone, 3 Story, 749, 753; Allen *vs.* Blunt, 3 Story, 742, 743; Carver *vs.* Braintree Manufacturing Company, 2 Story, 432, 438.)

It will be remembered by some of the members of this Court that one of the essential elements of the Woodworth planing machine patent was the pressure rollers to press the under face of the plank, as it passed through the machine, into contact with the bed or gauge plate to insure the reduction of the plank to an equal thickness by planing

one side only, however warped or bent the plank might 33
be.

The defendants in the litigation under that patent contended that pressure rollers were not described or represented in the specification or drawings of the original patent. And on the part of the plaintiffs witnesses were called who testified that in the machine first built by Woodworth, at Hudson, and removed to the Dry Dock in New York, before the date of the original patent, had pressure rollers, and it was argued that as the evidence of the successful working of the machine before the date of the patent was beyond contradiction, those who testified 34
that the machine had pressure rollers must be right, as it was demonstrable that, without rollers, the machine could not have worked.

I have given the above explanation as introductory to the ruling of the late Chief Justice Taney, in the case of Wadsworth and Wilson *vs.* Brown. This was on the trial of issues out of chancery in a suit under the re-issue of the Woodworth patent. The original patent was dated Dec. 27, 1828, and the re-issue July 8th, 1845. 35

The learned Chief Justice, in his instructions to the jury under the second issue, said:

"In determining the second issue, the jury will inquire whether the patent of 1845 contains any new mechanical combinations or means for producing the effect proposed, which were *not invented by Woodworth before the patent of* 1828; if it does, and the jury find them to be substantially different from those *invented before* 1828, *and then in-* 36
tended to be patented, then the patent of 1845 is invalid and inoperative. But a difference in the description of the two patents does not necessarily make them describe different improvements as the inventor is authorized by law to correct, in the re-issued patent, the errors or imperfection of the description in his first, *provided his invention and discovery was actually made before his first patent issued.* Neither will the substitution of one known mechanical equivalent for another make it substantially different, nor the

more perfect adjustment of the different parts of the same combination or means, or instruments, *provided the same combinations, means and instruments were intended to be covered by the first patent;* but if any new combination, means, or instruments, or mechanical powers are introduced into the patent of 1845, which are material in the operation of the machine, *and which were not invented by Woodworth previous to the patent of* 1828, *and intended to be covered by it,* then the last patent is substantially different from the first. And if such material alteration or addition was even invented by Woodworth himself after the patent of 1828, *but was unknown to him and undiscovered at the time he obtained that patent, still the second patent would be invalid, and the defendant entitled to a verdict on this issue.*"

I am not aware that this case has ever been reported, but I had an authenticated copy of the charge, and during the time the late Chief Justice presided in this Court, I cited the above passage in a brief which I had the honor to submit to this Court in Battin *vs.* Taggart, afterwards reported, (17 Howard 74, 80.)

It is clear from this charge that in the opinion of the late Chief Justice, the reissued patent could include matter not found in the original patent or the record of the application, and that it is competent by evidence *dehor* the record to prove that the matter so introduced in the re-issue was part of the original invention, and intended to have been secured by the original patent.

The rulings of the Courts in several of the cases cited in the brief of my learned associate are in conformity with the views of the late Chief Justice Taney in the charge above cited.

In Stimpson *vs.* Westchester R. R. Co., 4 Howard, 380, 401, the identity of the subject matter claimed in the re-issue with the subject matter intended to have been patented by the original patent, was made to depend wholly upon evidence *dehors* the record, as the original patent and the record of the application were all destroyed. One part indispensable to the operation claimed, viz., the inner groov-

ed rail, was never described nor represented in the original 41
patent. Grooved rails were described by Stimpson in another patent for street railroads, composed of two rails having grooves for the flanches of the wheels to run in, but in this patent for turning curves, the rail grooved to receive the flanches of the wheels was not described, and without it a car could not turn the required curves, there being nothing to guide the wheels.

But it may be urged that such a construction of the statute will operate as a hardship on the public, who, up to the time of the re-issue had a right to assume that the parts so 42
introduced in the re-issue were public property. And although I am aware that this Court is not to be influenced in its judgment by the interests of parties, or even of the public, yet, as the law-making power, in framing a statute are bound to have regard to the public interest, the question of hardship may have an important bearing in considering the intention of Congress in framing this law.

This seeming hardship, which will be, as it was before, pressed, will melt into thin air under the influence of reason. 43

By the terms of the statute, "The patent so re issued * * * * shall have the same effect and operation in law, on the trial of all actions hereafter commenced for causes subsequently accruing, as though the same had been originally filed in such corrected form before the issuing of the original patent."

To test this question of hardship, we must inquire what are the comparative advantages and disadvantages to the patentee and to the public resulting from the privilege conferred by the provision of the statute. The advantage 44
to the patentee is rendering his natural right as the first inventor legal after he had, by inadvertence and mistake, failed to make it legal, but the penalty imposed by the act for the inadvertence or mistake is the loss of all claim of compensation for the use of the invention by others from the time of the grant of the original to the time of the grant of the re-issued patent. The penalty is surely sufficient, for no one, I presume, would contend that the

inventor should lose all his rights because of a mistake in applying for the original patent.

The public, on the contrary, instead of being injured by
45 the inadvertent error of the patentee, have been greatly benefited. If the original patent had been properly granted, the public at large would have been obliged to pay for the privilege of making, using, and selling the invention from the time of the grant of the original patent. But instead of having to pay for the whole term of the patent, in consequence of the error committed by the patentee, the public who have made, used and sold the invention are relieved from all claim up to the time of the re-issue, and can only be held for what they may make, use and sell from the time of the grant of the re-issue.

The hardship bears on the inventor, and not on the
46 public. To make the inventor lose all his right of property because of inadvertent errors in defining the nature and scope of his invention within the terms of the law, was deemed to be unjust. And for that reason Congress provided for the amendment of the grant whenever by reason of inadvertent errors the patent should be either inoperative or invalid, and as this is obviously the clear intent of the statute, we respectfully submit that it should be so construed as to provide for the correction of all inadvertent errors, if the language will admit of such an interpretation.

In the case of Battin *vs.* Taggart, 17 Howard, the patentee
47 described a machine for breaking and screening coal, disclaimed the part of the machine by which the coal is broken, as that had long been used for breaking ores; and claimed the manner in which he had arranged and combined with each other the breaking rollers and the screen.

This statement was an error into which he was led by his attorney. He surrendered the patent and obtained a re-issue, in which he claimed the machine for breaking (the very thing which he had disclaimed in the original,) and this Court held that under the provisions of the thirteenth section of the patent act of July 4th, 1836, he was entitled

to do so if the disclaimer in the original patent was made 48
by inadvertence and mistake.

Is there any reason why the statute should provide a remedy for such an error, and not provide a like remedy for the error of the patentee in this case? Both were errors proved to have been committed by inadvertence, and obviously not with a view to mislead the public, for both on the grant of the original patents introduced their inventions into public use. It was through them, and them alone, that the public derived the benefit of the inventions. To permit the one to correct the 49
inadvertence by a re-issue of his patent, and deny a like remedy to the other, would seem to be unjust.

We have looked in vain for any terms in the statute which make it a judicial necessity to so construe the statute as to make the errors committed by Carhart an exception; but, on the contrary, we submit that the terms of the thirteenth section are in full accord with the spirit of justice which obviously inspired its enactment, and that instead of discriminating to grant the re-issue to one class of errors, and deny it to others, it extends it to all which 50
have arisen from inadvertence, accident or mistake, and without any fraudulent or deceptive intention.

It is difficult to comprehend in what manner the public can be injured by the introduction in a re-issue of some part of the original invention inadvertently omitted in the original patent.

By the provisions of the thirteenth section the new or amended patent is to have the same effect and operation in law, on trial for cases subsequently accruing as if originally granted in the amended form. 51

The whole proceeding and inquiry, except as to infringement; goes back to the date of the original grant. To apply the test to the present case. The complainants below put in evidence the re-issued patent, which was prima facie evidence, and no more, that it was granted for the invention intended to have been patented by the original patent. The respondent then put in evidence a certified copy of the original patent, which clearly proved, on its face, that

the subject matter of the second and third claims was not in the original patent. If the case had rested there the case would have been with the respondent so far as regards the second and third claims. But the complainant then produced evidence proving that the subjects of these two claims made part of his completed invention before he applied for the original patent, that he intended to secure them by that patent, and that the omission was the result of inadvertence and mistake, and that they were not omitted for any fraudulent or deceptive intention. And all this was proved beyond the possibility of contradiction. Ingenuity cannot conceive the omission for any fraudulent or deceptive purpose, particularly as Carhart when his completed invention was taken to the Patent Office, explained and pointed out to the machinist of the office the reed cells and the concentrating chamber, and the purpose for which he had invented them and the improvement in the instrument affected by them.

That the respondent below was not misled or taken by surprise by this course of proceedings is clearly established by the fact that in his answer to the bill of complaint he not only charges that certain matters claimed in the re-issue were not described or represented either in the description or the drawing of the original patent, or in the model which remained on file in the Patent Office. And then charges that Carhart, the patentee, was not the original and first inventor of either of the improvements claimed in the said re-issued letters patent, and gives the names of the persons whom he intends to prove had prior knowledge of the said improvements and where they were used.

(Record pp. 11, 13, 14.)

The whole case was tried as if the patent had been originally granted in the amended form, as required by the thirteenth section of the act of 1833, with the addition of the question whether the matters claimed in the re-issue, and not found in the original patent, made parts of the

invention completed before the grant of the original pa- 56
tent, and intended then to have been secured. And with the further plea of abandonment set up in the answer, (Record p. 14.) That this plea can have no efficacy is shown in the brief of my learned associate, and by the authorities therein cited.

The respondent had full notice and could and did avail himself of every defence which the law would have permitted him to make if Carhart had not made the mistake in applying for the original, and which necessitated the re-issue. 57

The present is a second re-issue of the original patent, the first having been obtained on the 24th of June, 1856, and surrendered to obtain the present re-issue in 1857. In obtaining the first re-issue no effort was made to introduce the subject matter of the second and third claims of the present re-issue. This circumstance will be urged in argument on the part of appellee, to show that even in 1856 Carhart had no idea of making claim to the subject matter of the second and third claims. The answer to this is that the evidence to prove the completed instrument taken to 58
the Patent Office in 1846 was not in the possession of the parties. The instrument itself was not discovered until the early part of 1857. See deposition of J. B. Donelan, Record, 2 Cross Int. p. 77.

To have made the attempt to introduce the reed cells and concentrating chamber in a re-issue without the evidence of Knowles and Donelan, and without the original instrument itself would have been a hopeless task, but when these were found the proof was complete to show, not only that Carhart did invent all these improvements 59
before the grant of the original patent, but that he exhibited and explained them to the Patent Office when he went there to apply for his patent.

60 **II.**

If this Court shall hold that the introduction of the subject matter of the second and third claims in the re-issued patent is not justified by statute, then we respectfully submit that that can only invalidate those two claims, but not the first, there being no proof of fraud in the introduction of the second and third.

The patent act of March 3d, 1837, section ninth, introduced a new feature in the law of patents. Prior to that
61 enactment, if it appeared in the course of a trial that any one thing claimed by the patentee, however trivial, was known prior to his invention, notwithstanding the proofs also established that the patentee was the true and original inventor of all the other parts, however important, and that the defendant had used all the important parts without authority from the patentee, and did not use the part claimed without right, nevertheless, the law pronounced the whole patent void, and judgment had to be rendered in favor of the defendant.

62 Such was the law, as we derived it from England, and there based on the assumption that the patentee in making such a claim, however innocently, had deceived the Crown: thus at once assuming that the Crown, by fiction of British law the perfection of wisdom, could be deceived by the subject, and that the patentee possessed the attributes of ubiquity and omniscience, for it assumed that he could be present everywhere, and know everything, and could not make a mistake.

The ninth section of the act of 1837, provided that
63 in such a case the Court should hold the patent to be good and valid in law for the part or parts proved to have been first invented by the patentee, and render judgment in his favor; but without taxable costs. By the first proviso to the section it is required that the part of the invention proved to be valid, must "be a material and substantial part of the thing patented, and be definitely distinguishable from the other parts claimed without right."

By the provisions of the seventh section of the same act 64
a disclaimer of the part or parts claimed without right, may be entered in the Patent Office without the necessity of re-issuing the patent.

Under the above recited provisions of the statute, if it shall be held that the second and third claims of the patent at issue were introduced in the re-issue without authority of law, and that they are void, the patent can be sustained and the respondent held as an infringer, provided the subject matter of the first claim is definitely distinguishable from the subject matter of the other claims, which may 65
then be disclaimed by filing a disclaimer in the Patent Office.

O'Reilly *vs.* Morse, 15 How., 120, 121.
Hall *vs.* Wiles, 2 Blatchford, 194.

It would be difficult to find a patent with several claims in which the subject matter of each claim would be more definitely distinguishable from the others than the first claim of the Carhart re-issue is from the second and third. The first claim relates to the arrangement of the bellows 66
and its connection with the reed board, and can be used with advantage without the reed cells, covered by the second claim, or the concentrating chamber covered by the third claim. It is true that the reed cells are claimed in combination with the reed seats or reed openings, and that both the reed cells and concentrating chamber are claimed to be used in connection with a suction or exhaust bellows, but not necessarily with one having the specific arrangement covered by the first claim. The subject matter of the three claims are so readily distinguished the one from 67
the other, that the reed cells, and the concentrating chamber can be taken out of the instrument in a few minutes without the slightest change in what is covered by the first claim. They are not so separable that they could not be claimed in combination, but they are clearly separable—either in the instrument as a construction, or in the specification of the patent, wherein each is defined and distinguished from the others by words.

68 But the most conclusive evidence that they are separable is found in the fact that the subject matter of the second and third claims were entirely omitted in the original patent. As the original patent was granted for the subject matter of the first claim, and the re-issue for that and in addition thereto for the subject matter of the second and third claims, the subject of the first claim, in the language of the act "must be a material and substantial part of the thing patented, and be definitely distinguishable from the other parts so claimed without right."

69 In the case of O'Reilly *vs.* Morse (15 How.), this Court held the eighth claim to be void, not because Morse was not the first discoverer of what was sought to be covered by that claim, but because he sought to claim what the Court held could not be legally claimed, viz.: recording signs by the motive power of electricity, however developed.

This claim was first introduced in the re-issue of the patent. And what was sought to be covered by this claim was the spirit that pervaded the whole patent, and
70 from which, in one sense, no other part could be separated and be operative, and yet this Court did judicially separate them, for that claim was declared to be void, and all the other claims valid, and O'Reilly was enjoined and ordered to account.

CHAS. M. KELLER.

Supreme Court of the United States.

December Term, 1866.

IN EQUITY.

JEREMIAH CARHART, ET AL., Plaintiffs in Error,

VERSUS

CHARLES AUSTIN, Defendant in Error.

DEFENDANT'S BRIEF.

Edmund Burke,
FOR DEFENDANT IN ERROR.

McGill & Witherow, Printers & Stereotypers, Washington, D.C.

Supreme Court of the United States.

DECEMBER TERM, 1866.

IN EQUITY.

JEREMIAH CARHART, ET AL., PLAINTIFFS IN ERROR,

vs.

CHARLES AUSTIN, DEFENDANT IN ERROR.

DEFENDANT'S BRIEF.

THE ISSUES.

In this case the defendant alleges in his answer to the plaintiffs' bill of complaint, and believes he has sufficiently proved by the evidence—

1st. That the devices or improvements claimed by the complainant, Carhart, in his reissue patent of August 18, 1857, were not represented, described, nor claimed by him in his model, drawings, or specification, deposited and filed in the Patent Office on his application for the original patent, dated December 28, 1846, nor in the specification and drawings annexed to said patent; and that, therefore, the said reissue patent is void in law.

2d. That the specification and claims annexed to his said reissue patent of August 18, 1857, are not sufficient nor valid in law.

3d. That the said Carhart has abandoned his alleged invention to the public.

4th. That the said Carhart is not the first and original inventor of the improvements in melodeons, &c., claimed by him in his said reissue patent of August 18, 1857; and therefore, has no right by law to recover in this case.

These several propositions will now be considered in the order in which they have been stated:

I.

THE REISSUE PATENT COVERS NEW MATTER, AND IS THEREFORE VOID.

The last amended patent contains new matter not represented nor set forth in the original drawings, model, or specification, and is therefore void. It is void on two grounds:

1st. that it claims a *new* and *different* invention from that which was set forth and claimed in the original patent.

2d. It is a fraud upon the public, inasmuch as it covers and claims devices which all other persons had then, and have now, a legal right to use.

That new matter is the *reed-cells* and *concentrating chamber*. The fact is proved by the model in the Patent Office, an exhibit in this case, and the drawings and specifications annexed to all the patents put in evidence in this case, to which this honorable Court is respectfully requested to refer.

1. *The Law upon the Subject.*

Act of Congress to promote the progress of the useful arts, July 4, 1836, sec. 6. The section referred to requires, first, drawings representing the invention; second, a model; third, a description. These must represent the invention claimed in full, clear, and exact terms. It is a condition precedent to the issue of a patent; and, if issued without them, the patent is void. Those requisites of the law were complied with on the issue of the original letters patent, and the patent was supposed to cover the improvements therein described and claimed.

2. *The Surrender and Reissue of a Patent.*

If the original patent was defective for any cause declared by law to be a sufficient reason, it could be surrendered for reissue. See sec. 13, Act of July 4, 1836. The reissue must be for "the same invention;" that is, for the one originally applied for, and no other.

The original patent must also be defective and inoperative by reason of insufficient description, resulting from error, inadvertency, or mistake; and on this point it is respectfully submitted that the original patent must, before it can be surrendered for reissue, be adjudged by some court of competent jurisdiction to be "inoperative or invalid, by reason of a defective or insufficient description or specification, or by reason of the patentee claiming in his specification as his own invention more than he had or shall have a right to claim as new."

These are the specific causes which authorize the surrender and reissue of letters patent. The patent must be inoperative or invalid for the causes set forth in the statute; not because the patentee describes and claims matter which is not new and original, but which is old and not patentable. In the latter case the patent fails for want of novelty and originality, and not for "insufficient and defective description," nor "by reason of the patentee claiming" more than he has invented and is entitled to secure by letters patent.

And these questions are eminently judicial. They belong to the courts to settle, and are to be determined in the due course

of legal proceedings. They are not within the jurisdiction of the Commissioner of Patents. By what legal authority does that officer say that a patent has become inoperative or invalid for the causes set forth in the statute, before it has been so adjudged in due course of law? Nor is there any statute which authorizes the patentee himself to sit in judgment on his own patent, and decide that it has become inoperative and invalid, for the reasons assigned in the act of Congress touching the subject. This position seems to be sustained by the reasoning of the court, in Burr *vs.* Duryee, 1 Wallace, 570. See also Moffit *vs.* Garr, cited in Law's Am. Dig., p. 616.

Applying a sound criticism to the 13th section of the act of 1836, it is believed that the practice of the Patent Office regarding reissues has heretofore been wholly unwarranted by its provisions.

4. *Grounds assumed by the Complainants.*

It is not contradicted by the complainant that the reissue patent of August 18, 1857, does cover new matter, not represented, described, nor claimed, in the original model, drawings, and specification; on the contrary, it is admitted that it does describe and claim the new devices, not represented, described, nor claimed in the original application or patent, namely, the *reed-cells* and *concentrating chamber*.

And it was contended on the trial in the lower court, and, it is presumed, will be contended here, by the complainants, (*a*) that the original invention of the complainants' contained the devices in controversy; (*b*) that the Commissioner in his action upon the reissue had authority to receive testimony *aliunde* the Patent Office of the fact of such invention, and (*c*) that his action is conclusive with respect to the matter.

(*a*) With regard to the first ground assumed by the complainants, it is submitted that the evidence does not sustain the position that the original invention contained all the devices described and claimed in the reissue patent of August 18, 1857.

The complainants have put in evidence an Exhibit called the "Wing" model. And they allege that this model is a *fac simile* of the model, or rocking melodeon, on which the complainant Carhart experimented in his earliest endeavors to improve reed instruments, (viz: in 1838. See Ev., depositions of Jeremiah Carhart, John G. Wing, Frederick Oliver, and Alfred E. Badger,) and which actually contains the invention claimed in the reissue patent of August 18, 1857. Himself, and the witnesses examined by him, viz: the said Wing, Oliver, and Badger, all say that his great purpose was *to improve the bellows of the instrument so as to draw the wind down instead of forcing it up through the reeds.* The "Wing" model shows the device of the improved bellows, and that alone. It had no reed cells nor concentrating chamber

could not have. It is plainly evident, from the structure of the model, that it could have no such devices connected with it. Nor is it to be found in the Patent Office model, also an Exhibit in this case. In 1846, quite eight years after the alleged improvement applied to the rocking melodeon was made by Carhart, the *reed-cells*, but not the concentrating chamber, appear in the melodeon, known in this case as the "Knowle's instrument;" many years after the reed-cells were attached to the melodeon, introduced in evidence by defendant, called the "French" instrument. (See depositions of Matilda French and John F. Garvey.)

The instrument presented to the witness Knowles was not the model furnished to the Commissioner, as required by sec. 6, act July 4, 1836. It never came to his knowledge, nor was ever received by him as a model.

The defendant, therefore, believes he is right in assuming that there is no sufficient nor satisfactory proof of the fact that the reed-cells and concentrating chamber were a part of the invention originally claimed by Carthart as an improvement in the bellows of reed instruments. And in those two particulars, the reissue patent of August 18, 1857, covers and claims new matter, not described nor represented in the original specification, drawings, and model.

(*b*) With regard to the second ground which may be taken by the complainants, if Carhart had, in fact, invented the reed-cells and concentrating chamber, at the time he claims to have made his original invention, viz., the improvement in the bellows, and had failed to represent, describe, or claim them in his original patent, drawings, or specification, the defendant denies that the Commissioner had power to receive evidence *aliunde* the Patent Office, to prove the fact of such invention of the devices in question.

The law (Act of Congress, of July 4, 1836, secs. 6 and 13) authorizes the Commissioner to act only on the model, drawings, and description, deposited with the original application. It contemplates no other evidence, nor gives the Commissioner power to receive any other.

The "invention" contemplated by the 13th section of the act of 1836, is the invention *defectively* described in the patent. It is not *another* invention or device *not* represented, described, claimed, nor alluded to, in either the original model, drawings, or specification. To give so wide a construction to the statute in question, would open the door to innumerable frauds upon the public and upon other inventors. It would enable a dishonest and fraudulent patentee, by the finesse of a surrender and reissue, to claim and secure valuable inventions made subsequently to his, and thus deprive the true inventor of his just rights, and to cover and hold devices which had become public property, which is equally sacred and equally entitled to protection by the tribunals of justice.

The great danger of fraud upon the public, and upon individuals, growing out of the loose practice heretofore adopted, with regard to reissues, has led to proper and just animadversion by this court. See Burr *vs.* Duryee, before cited, and ~~Cole~~ *vs.* Brown, 2 Wallace, 320, reaffirming the doctrine of the former case.

(*c*) With regard to the third position assumed by the complainants, viz: that the action of the Commissioner is conclusive with respect to the matter of reissue it is replied that such a doctrine cannot be maintained on any sound principle of reasoning.

The Patent Act of July 4, 1836,

exceeded his powers, and his acts are void. It seems to absurdity to hold that this exercise of power cannot be inquired into by the courts; but, on the contrary, the decision of the Commissioner is conclusive. Justice and reason dictate that his acts in no case should be conclusive. If they are so held, both public and individual rights rest on a very frail tenure, so far as they may be affected by the reissue of patents.

Nor can the decision of the Commissioner, in the case of a reissue, be regarded as an executed power, any more than in the original grant of a patent, and thus pass beyond the power of revision by the competent tribunals.

The decision of the Commissioner, in the case of a reissue, involves a similar consideration of fact and law, as in the original application; and this the law contemplates. See sec. 8, Act of

could not have. It is plainly evident, from the structure of the model, that it could have no such devices connected with it. Nor is it to be found in the Patent Office model, also an Exhibit in this case. In 1846, quite eight years after the alleged improvement applied to the rocking melodeon was made by Carhart, the *reed-cells*, but not the concentrating chamber, appear in the melodeon, known in this case as the "Knowle's instrument;" many years after the reed-cells were attached to the melodeon, introduced in evidence by defendant, called the "French" instrument. (See depositions of Matilda French and John F. Gurney.)

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The great danger of fraud upon the public, and upon individuals, growing out of the loose practice heretofore adopted, with regard to reissues, has led to proper and just animadversion by this court. See Burr *vs.* Duryee, before cited, and ~~Cole~~ Case *vs.* Brown, 2 Wallace, 320, reaffirming the doctrine of the former case.

(*c*) With regard to the third position assumed by the complainants, viz: that the action of the Commissioner is conclusive with respect to the matter of reissue it is replied that such a doctrine cannot be maintained on any sound principle of reasoning.

It is a question of powers. The Patent Act of July 4, 1836, confers certain powers upon the Commissioner of Patents, touching the issue and reissue of patents. If he exceed the powers thus granted, his acts are simply void. It is hardly necessary to cite authorities to sustain the proposition that all the acts of public officers or private agents, not within the powers granted by law or deed, are simply void.

The Commissioner of Patents, in the discharge of his duties, is governed by this principle. In the primary issue of patents his powers are very comprehensive. He has jurisdiction of all matters which touch the life and vitality of patents, namely: novelty, utility, abandonment, and waiver. See Patent Act of July 4, 1836, sec. 6; Shaw *vs.* Cooper, 7 Pet., 292.

His acts, growing out of the exercise of these powers, are subject to revision and correction in the tribunals of justice. His decision is not conclusive with regard to either novelty, utility, or abandonment.

With respect to reissues his powers are confined to the reissue of a patent, "for the *same* invention"—that is, the invention defectively described and represented in the original model ~~and~~ specifications and drawings. See Patent Act, July 4, 1836, sec. 13. That is the language of the law. Therefore, if he reissues a patent covering another and different invention from that set forth and represented in the original application, he has exceeded his powers, and his acts are void. It seems to be an absurdity to hold that this exercise of power cannot be inquired into by the courts; but, on the contrary, the decision of the Commissioner is conclusive. Justice and reason dictate that his acts in no case should be conclusive. If they are so held, both public and individual rights rest on a very frail tenure, so far as they may be affected by the reissue of patents.

Nor can the decision of the Commissioner, in the case of a reissue, be regarded as an executed power, any more than in the original grant of a patent, and thus pass beyond the power of revision by the competent tribunals.

The decision of the Commissioner, in the case of a reissue, involves a similar consideration of fact and law, as in the original application; and this the law contemplates. See sec. 8, Act of

March 3, 1837. That act gives the Commissioner the power of revision and correction, and the patentee the right of appeal. The decision of the Commissioner, in the issue of the original patent, as well as the reissue, involves matter of fact and of law, and is judicial in its character. It is as much an executed power in one case as the other, and should be as conclusive in one case as the other. The doctrine of Judge Story upon this point, laid down in Allen *vs.* Blunt; 2 Story, 742, and in Woodworth *vs.* Stone, 3 Story 759, opens the door of injustice and error. It gives the Commissioner of Patents almost unlimited power over the fortunes of inventors and the rights of the public. Congress could never have intended to confer upon a public officer such unlimited and unrestricted powers. But Judge Story himself speaks doubtingly of the principle he lays down. Woodworth *vs.* Stone, before cited.

It is now settled that the question, whether the invention claimed in the reissue is the same invention claimed in the original patent, is a proper question for the jury. Stimpson *vs.* The Westchester Railroad Company, 4 Howard 380. #

The Commissioner of Patents has power only to amend the description of the invention *originally* presented, and not one *subsequently* brought to his knowledge.

5. *The Reissue covers a New and Different Invention.*

On the face of the patents it appears that the reissue was for a new and different invention from that which was represented and described in the original application, and, therefore, this case comes within the principle of Judge Story's decision in Allen *vs.* Blunt.

This fact will appear upon a full and careful examination and analysis of the several patents, original and reissues. It is proposed now to make that examination and analysis of the patents side by side, thus showing their respective coincidences and differences.

6. *Analysis of the several Patents.*

Original Letters Patent. Dated December 28, 1846.	**1st. Reissue Letters Patent.** Dated June 24, 1856.	**2d. Reissue Letters Patent.** Dated August 18, 1857.
TITLE.	TITLE.	TITLE.
1. *In the Letters Patent:* "A new and useful improvement in BELLOWS for Musical Instruments."	1. *In the Letters Patent:* "A new and useful improvement in BELLOWS for Musical Instruments."	1. *In the Letters Patent:* "A new and useful improvement in REED MUSICAL INSTRUMENTS."
2. *In the Specification:* "New and useful improvements in the BELLOWS of that class of musical instruments called Melodeon, Seraphines, Æolian Attachments," &c.	2. *In the Specification:* "New and useful improvements in THAT CLASS OF MUSICAL INSTRUMENTS called Melodeons, Seraphines, Æolian Attachments," &c.	2. *In the Specification:* "New and useful improvements in THAT CLASS OF MUSICAL INSTRUMENTS called Melodeons, Seraphines, Æolian Attachments, *or* in the BELLOWS therefor."

Alex. Ballin et al v. Taggart et al. 17 Howard 741.

3. *Difference between the Carhart and other instruments:*

"In instruments of the kinds above referred to, and all others in which reeds are vibrated by a current or currents of air, the BELLOWS is so constructed as *to blow or force the current against the reeds, instead of drawing the current down through the reeds by an exhausting action of the bellows, as in the method adopted by me.*"

4. *Object of the Invention:*

"The objects of my invention are to produce a constant current of regular force, except when required to be increased to produce the swell, and so to arrange the parts as to occupy less room than by the modes heretofore practiced."

5. *Position of the Reeds:*

"The reeds are placed over the apertures in the sound-board in the *usual manner*," &c.

6. *Reed-Cells:*

None described nor alluded to.

3. *Difference between the Carhart and other instruments:*

After stating five different defects resulting from the old construction of reed musical instruments the patentee says:

"My invention consists principally in *so constructing, combining, and arranging* the parts of said reed instruments that the reeds shall be vibrated in playing *by the rushing of the external air* INWARDS to a partially exhausted chamber, instead of *forcing it outward* as formerly practiced."

4. *Object of the Invention:*

The reeds "will speak immediately, and the tone will be improved, as will be observed on experiment, thus at once obviating the leading defects of the old construction."

5. *Position of the Reeds:*

"The reeds are placed over apertures in the sound-board in the *usual manner*," &c.

6. *Reed-Cells:*

None described nor alluded to.

3. *Difference between Carhart's and other instruments:*

"In instruments constructed before my improvements, some parts of the reeds were uniformly found to be slow in speaking, and would often entirely fail. They would either not speak at all, or would give their tones out of tune. The sound of the reeds was also disagreeable, 'reedy,' and nasal to such a degree that the instrument could not be extensively introduced. In all, or *nearly all*, of these instruments, the bellows was so arranged as to blow the air *through* the reeds; and in all attempts previously made to *produce tones by exhaustion* the instruments have been so encumbered with tubes and wind-chests between the bellows and the reeds, that pre-existing evils have rather been increased than diminished, although the exhausting bellows, when properly used, is a vast improvement over the blow bellows."

4. *Object of the Invention:*

"The object of my invention is to improve the tone of the reeds, and impart to them promptness and certainty in responding to the touch of the keys, and at the same time to give a compact and convenient and graceful form to the instrument."

5. *Position of the Reeds:*

"The reeds are placed over apertures in the sound-board, which may be called reed-openings or apertures, in the *usual manner*," &c.

6. *Reed-Cells:*

"Directly over each reed is a cap, closely fitting upon the reed-board, forming a cell over the reed and reed-openings about the length of the reed. This case is open at one end of the reed, but closed at the other, and is in width and in depth, on an average, about three-eighths of an inch, but should be slightly increased for the large reeds and diminished for the small ones."

7. *Concentrating Chamber:* None described.	7. *Concentrating Chamber:* None described.	7. *Concentrating Chamber:* "About three inches from the mouth of the reed-cells and on the lower leaf of the exhaust chamber, I place a board in a vertical position, which I call the concentrating board, which extends to the ends and top of the instrument, thus forming a narrow chamber, open substantially at the top, but extending the whole length of the reed-board."
8. *Drawings:* Contain four figures.	8. *Drawings:* Contain four figures, the same as attached to original patent.	8. *Drawings:* Contain five figures, the four first of which are the same as attached to the original patent. The fifth is new and represents the reed-cells and concentrating chamber.
9. *Claims:* "What I claim as my invention, and desire to secure by letters patent, is *making an Exhausting Bellows for Reed Instruments*, consisting of two chambers combined with each other, and with reeds placed above, so that the chamber next the sounding board shall be enlarged by a weight on the first flap, substantially as herein described, and exhausted by the action of the second flap, substantially as described. "I also claim the method of making the valves by means of straps of leather, or other materials of like properties, placed over a hole, or series of holes, in combination with a cord of India rubber, or other elastic substance, substantially as described, whereby the valve is prevented from sagging when slacked by air and making noise by striking the valve seat, as described."	9. *Claims:* "What I claim as new therein and as my own invention, and desire to secure by letters patent, is *the combination of the reeds with an exhaust chamber of variable capacity, and an air-pump whose action exhausts and rarifies the air therein*, the exhaust chamber tending to expand with a force that will balance the rarefaction to be preserved in the chamber, for the purposes herein set forth."	9. *Claims:* "What I claim as my invention, and desire to secure by letters patent, is *so connecting* the board which contains the reed-seats, or perforations for the reeds *with* the exhausting bellows, that it shall form substantially a part of the stationary leaf or cover of the exhaust chamber thereof, while the exhausting or pumping chamber is placed in immediate connection with the said exhaust chamber, without the intervention of tubes, thus improving the tone of the reeds and expediting their speaking, and giving a compact, light, and graceful form to the instrument, substantially as described. "I also claim the *reed-cells in combination with the reed openings*, substantially as described. "I also claim the *concentrating chamber in combination with the reed cells and reed-seats*, substantially as described. "I claim the last two combinations specified, ONLY *when they are to be used with a suction or exhaust bellows capable of producing a continuous current of air through the reed-openings*, as set forth."

7. *Variances between the several Patents and Specifications.*

1. *As to the title in the Letters Patent.* In the original patent the title is "A new and useful improvement in the *Bellows* for Musical Instruments."

In the first reissue it is the same.

In the second reissue, now in controversy, the title in the original patent is abandoned, and a new title set up, viz: "A new and useful improvement in *Reed Musical Instruments*.

2. *As to the title in the Specifications.* In the specification to the original patent, the title or invention claimed is "New and useful improvements in the *bellows* of that class of musical instruments called Melodeons," &c. In the first reissue the title is, "New and useful improvements in *that class of Musical Instruments* called Melodeons," &c., embracing the specific improvement in the bellows as set up in the original specification. In the second reissue the title is "New and useful improvements *in that class of Musical Instruments* called Melodeons, &c., *or* in the *bellows* thereof."

3. *As to differences in principle between the Carhart and other Instruments.* Substantially stated, in the specification to the original patent, the inventor alleges the difference to be in *the manner in which the air* is made to pass through the reeds. In other instruments it is *forced* through. In his, it is *drawn* through by suction. In the first reissue this difference in principle between other instruments and Carhart's is substantially stated to be the same. In the second reissue the difference alleged is in the *speaking of the reeds.* It will be here noted that in the last reissue the *idea of the original invention*, which Carhart supposed he had first made, is *abandoned entirely*, and a new invention or improvement set up.

4. *As to the objects of the alleged invention.* In the specification attached to his original patent, Carhart alleges his object to be to *produce a constant current of regular force*, &c., and so to *arrange the parts as to occupy less room.* In his first reissue he alleges his object to be *to cause the reeds to speak more readily*, and to *improve the tone.* In his second reissue he alleges his object to be substantially the same as in his first. These variances also show that he had abandoned the invention which he originally supposed he had made and claimed, viz: an improvement in the *bellows*, whereby the air was *drawn down* through the reeds instead of being *forced up* through them, and now claims improvements in the instrument generally.

5. *As to the reed-cells.* In his original specification he neither describes, nor claims, nor alludes to reed-cells; nor are they represented in the drawings or model. In his first reissue he makes the same entire omission. In his second reissue, for the first time, he describes and claims them. This is new matter—another and different invention from that which was described and claimed in his original patent and first reissue.

6. *As to the concentrating chamber.* Like the reed-cells, it is entirely omitted in Carhart's original patent and first reissue, and is only described and claimed in his second reissue. And, like the reed-cells, it is another and different invention from that described in the original patent and first reissue.

7. *As to the drawings.* The drawings attached to the original and first reissue patents are the same. The alleged invention is represented in four figures, neither of which contains the reed-cells and concentrating chamber. In the second reissue, the drawings consist of five figures, four of which are the same as those attached to the former patents. The fifth is new and additional, representing for the first time the reed-cells and concentrating chamber.

8. *As to the claims.* In the original patent Carhart claims first *making an exhausting bellows for reed instruments* in the manner set forth. And second, an *improvement in the valves* to the bellows in the manner set forth.

In his first reissue he abandons the specific improvement which he originally claimed in the bellows, and claims *the combination of the reeds with the exhaust chamber of variable capacity, and an air pump, which exhausts and rarifies the air therein.*

This is his first attempt through the instrumentality of a reissue *to enlarge his claims*, and to cover all the valuable improvements in the melodeon and other instruments of that class. It is an admission that neither the improvement in the bellows, which he originally claimed, nor the reeds were new with him, and were his property. But he attempted to cover both by the claim set up in his first reissue.

In his second reissue, Carhart abandons not only the specific improvement in the bellows, which effected a change in the principle of reed instruments, viz: drawing the air down through the reeds instead of forcing it upwards, which he supposed he had invented, but also the combination which he claims in his first reissue; and he sets up new and original claims of matter not represented, described, claimed, nor alluded to in either his original model, drawings, or specification. First, he claims so connecting the board which contains the reed-seats with the exhausting bellows that it shall form substantially a part of the stationary leaf, &c. Second, the combination of reed-cells with the reed openings. Third, the concentrating chamber in combination with the reed-cells and reed-seats; but these last only when they are used with a suction or exhaust bellows. This was another and great step in the process of enlargement of claims through the artful and ingenious agency of a reissue. Carhart's patent now covered and claimed all the great and substantially valuable features of that class of instruments, and inspired him with the belief that he could now control the whole manufacture. The address and skill with which this was done certainly implies more genius and talent in those by whom it was accomplished, than any of the improvements which Carhart has invented, if he has invented any.

8. *Legal Conclusions.*

The improvements, therefore, claimed in the second reissued patent, are not the "same invention" described and claimed in

the original patent, and, therefore, the case is not within the provisions of the thirteenth section of the act of 1836. They are new and different inventions. The fact appears upon the faces of the patents themselves, and, therefore, as before remarked upon the principles settled by Judge Story, in Allen *vs.* Blunt, the second reissue patent is void. The reissue must cover the same invention described in the original specification. (Batten *et al. vs.* Taggart *et al.* 17 Howard, 74.)

Again, there is a palpable and striking variance between the title set up in the original patent, and that set up in the second reissue, which, according to analogy with the principles of English patent law, touching variances between the title set up in the letters patent and that set up in the specification, should be fatal to the second reissue. (See Holroyd on Patents, p. 77, 78; Billing & Prince on Patents, p. 68–74; Spence on Specifications, p. 60–64; Hindmarch on Patents, p. 42–47; Rex *vs.* Wheeler, 2 Barn. and Ald., 349–351; Rex *vs.* Metcalf, 2 Stark, 249; Lord Cochrane *vs.* Smethurst, 1 Stark, 205.)

In this connection the counsel for the defendant in error respectfully refers this court to the able and luminous opinion pronounced by his honor Judge Clifford, on the decision of this cause in the court below, which will be found in the Appendix to this argument.

9. *Evils resulting from the practice of Reissuing Patents.*

It was formerly the rule of the Patent Office not to grant a reissue of letters patent containing matter not represented nor described in the original model, drawings and specification. This rule is necessary for the protection of the public and subsequent inventors. The right to inventions, not patented nor lapsed by expiration of the time for which the exclusive privilege is granted, belongs to all. It is against justice and public policy, as well as the law, to permit one inventor to appropriate the discoveries of another inventor, by surrendering his old patent and enlarging his claim, as seems to have been attempted in this case. It is an offense more odious than piracy, using the term in the technical sense, as applied to patents, and this practice, in certain cases, has been properly and justly animadverted upon by the Supreme Court of the United States, in Burr *vs.* Duryee, before cited. (See opinion of Justice Grier, p. 568, 572, 575, 577; and also Case *vs.* Brown, before cited, in which the doctrines of the preceding case are confirmed.)

These considerations demonstrate the importance and necessity of confining reissues to the plain provisions of the law, and of scrutinizing all reissued patents with jealous suspicion. If not, how can the public know what rights belong to them, or what belong to the patentee? And the courts of law are bound to protect the public as carefully as the rights of the patentee. The one right is as sacred as the other.

II.

INSUFFICIENCY OF THE CLAIMS.

The claims in the second reissue letters patent are insufficient to cover any invention or combination, and, therefore, the patent is void.

The claim is the summary of the specification, and precisely points out what the patentee claims to have invented.

It must not contain *more* than he has invented; if it does, the patent is void.

A material mistake in the claim or disclaimer is fatal.

It must contain patentable matter.

Mere arrangements of mechanism, involving construction only, are not patentable.

The claim must be definite in form, and clearly cover the invention.

(See Hindmarch on Patents, 196; Stanley *vs.* Whipple, 2 McLean, 38; Spence on Specifications, 78; Billing & Prince, Law and Practice of Patents, 105–7; Curtis on Patents, secs. 182–184; Whittemore *vs.* Cutler, I Gallis, 478; cited in notes, Curtis on Patents, sec. 40.)

Tested by these rules, how do the claims in the reissue of August 18, 1857, stand?

First Claim. (See letters patent for the claim *in extenso.*) It covers simply a *connection* of one thing with another. That act does not involve invention. To connect one thing with another is simply *an act*, and not invention. (See deposition of R. H. Eddy, Int. 8, p. 164 of Ev.)

Nor does this connection or arrangement produce one of the effects claimed for it, namely, improving the tone of the reeds, and expediting their speaking. These effects are as well if not better produced by instruments with tube connections on the principle of the "Fowle" bellows. (See depositions of George D. B. Prescott, Int. 9, 10, p. 160 Ev.; John H. Morey Ev., Int. 3–7, p. 183; William C. Hodgdon Ev., Int. 8–11, p. 185; Abraham J. Prescott, Ev., Int. 5–8, p. 188.) #

The other advantage claimed, namely, compactness, results from mere construction, and not invention. If that were patentable, placing the exhausting chamber of the bellows above the board, separating it from the exhaust chamber and behind the reed-board, as in the modern instruments, would be patentable. In Carhart's original model, the bellows is below the reeds. In those he now makes, the bellows is above the reed-board and behind the reeds, in this respect imitating the arrangement of the bellows in the "French" instrument. Such an arrangement does not involve invention. It is mechanical merely.

Second and Third Claims.—These are floating claims, operative or not, according to the kind of bellows used. Standing by them-

Alex Dana W. Deadcon. Ev. p. 187. Int. 12. 13.

selves, and without a disclaimer, they cover patentable devices, if they were new. But the last clause in the specification is a disclaimer of these very devices, except when used with a suction bellows. Therefore, standing *per se*, they are not claimed as patentable.

Nor do these claims, connected with the last clause in the specification, amount to a claim of any kind. The combination contemplated is not in fact claimed. The two claims, with the disclaimer, are inconsistent and suicidal. (See claims in the reissue of August 18, 1857.)

III.

ABANDONMENT OR WAIVER.

The improvements claimed by Carhart, in his amended patent, dated August 18, 1857, have been abandoned or waived, and forfeited to the public use. The facts relied upon to sustain this proposition are, (1) that he never claimed them in his original model, drawings, and description, of December 28, 1846; (2) nor in the first reissue patent, dated June 24, 1856; thus standing by and permitting the public to use them for the term of *eleven* years. To attempt to regain, by a reissue, rights thus waived and abandoned, would be a fraud upon the public.

As to what constitutes an abandonment, see Mellus *vs.* Silsbee, 4 Mason, 111; 4 Wash., 544.

Long acquiescence will be conclusive. Mellus *vs.* Silsbee, and Shaw *vs.* Cooper, 7 Peters, 292, 321.

It is not necessary that the inventor should intend to dedicate. The only question is, do his acts amount to a dedication or waiver? Curtis on Patents, sec. 302.

The case of Shaw *vs.* Cooper, is referred to as a leading case. That case recognizes the doctrine of waiver, forfeiture, and estoppel, as applied to inventors and patentees. And it is as reasonable that those principles should apply to a patentee who, not securing his invention in his original patent, stands by and permits others to use it for a series of years, as to an inventor who neglects to take out a patent in due time.

Thus in this case, Carhart, if he were the original inventor of the improvements which he now attempts to claim, stood by and saw others use his pretended invention for the long period of *eleven years*, before he thought of reclaiming the right which he thus abandoned.

The facts of this case distinguish it from others which have come before this honorable tribunal for decision. In the former, in accordance with legal presumption, it is to be supposed that the new features claimed in the reissue patents were in some manner represented and described in the original model, drawings, and specification. In this case they were not represented nor described in the original model, drawing, and specification,

nor in the first reissue. They first appear in the second and last reissue, eleven years after the date of the original patent. They are interpolations in the original invention as claimed by Carhart.

It is, therefore, assumed as sound law that when an inventor, under such circumstances, stands by and permits the public to use his invention, he waives and abandons all claim to protection by letters patent. Ballm Nat. v Taggart et al. before cited, Judge Metcalf, in that case, in Rubberland, y not in Woods. decides that the matter covered by the reissue must appear in the original patent.

WANT OF PRIORITY AND ORIGINALITY.

The fourth ground of defence is want of priority and originality of invention. The facts relied on to support this proposition, are—

1. *The proof furnished by the several Patents of Carhart.*

And here it is necessary to examine the specifications of all of them in connection with the "Wing" and Patent Office models, which are Exhibits in this case, in order to see what Carhart originally claimed and supposed he had invented.

(*a*) The specification of the patent of December 28, 1846, sets forth a "new and useful improvement in the *bellows*," and the claims point out and define improvements in the *bellows only*—no "reed cells," nor "concentrating chamber"—none in model nor drawings. It says, "the reeds are placed over the aperture in the sound-board in the *usual manner*." On referring to the "Wing" model, we find only the *reed seats* and *bellows;* and the same in the Patent Office model. The accordeon contains *reed seats, cells,* and *suction bellows.*

The conclusion is, that Carhart did not believe he had invented anything more than an improvement in the bellows.

(*b*) *He rests securely in this belief ten years.* He then discovers that he is not the first inventor of the improved bellows, and takes out an amended patent, dated June 24, 1856, claiming what he *then* supposed he had invented. In this patent he sets forth "*new and useful improvements,*" leaving off the words "in the bellows." He says that the invention consists "principally in so constructing, combining, and arranging the parts of said reed instruments, that the reeds shall be vibrated, in playing, by the rushing of the air *inward* to a partially exhausted chamber, instead of *forcing it outward,* as previously practised." And he claims the combination of the reeds with an exhaust chamber of variable capacity, and an air pump, whose action exhausts and rarefies the air therein, as the mechanism by which he makes his invention practical. He neither describes nor claims "reed-cells," nor "concentrating chamber," separately, nor in connection with anything. He claims simply the devices contained in

the "Wing" model, and also the Patent Office model. Neither are the "reed-cells," nor "concentrating chamber" described in the model or drawings annexed to the first reissue, thus showing that he did not contemplate those devices as having anything to do with his invention.

(*c*) *Another year elapsed, and Mr. Carhart gets new light.* He learns, by the sharp teachings of litigation, that his first reissue patent is not valid, and again surrenders and takes out his amended patent, dated August 18, 1857, under which he now claims. And what does he claim in this patent? Not the improved bellows, not the combination of the reeds and the exhaust bellows, but he does claim: 1. So connecting the reed-board with its seats, *with* the bellows, as set forth. 2. The combination of the reed-cells with the reed seats. 3. The combinati cells, reed seats, and concentrating chamber, *if usec* exhaust bellows; but *neglecting* to claim ~~that~~ combina

Not daring to claim the combination of the reed bellows, he attempts *to do the same thing* by a trick He calls it "connecting," &c.

The first claim in his last patent covers the very same combination claimed in his first reissue, if it has any meaning. The *finesse* is an attempt to cover the same thing by change of phraseology.

The combination of the reed-seats with the bellows would be nothing. Such a device could not make a musical sound. The reeds are one of the essential elements of the combination. Dropping out, "without the intervention of tubes," does not relieve the claim from the charge of absurdity.

But after twenty years of toil, new features now display themselves. They are the reed-cells and concentrating chamber. They are not to be found in the "Wing" model nor Patent Office model. For the first time they appear in the second reissue; for the first time in the drawings—additional ones having been filed in the Patent Office.

Now by this corrected, amended, improved, and *enlarged* patent, Carhart evidently hopes to monopolize the whole business of melodeon making.

If such a practice is sustained by courts of justice, what safety is there for the public or for the subsequent inventor?

In view of this case, it is believed that the practice of surrendering patents for reissue should be watched with jealous care. It is not to be looked upon with favor by courts of justice.

It is, therefore, respectfully submitted, that the evidence furnished by the several patents themselves, and the circumstances under which they were obtained, afford sufficient proof of the fact that Carhart is not the first and original inventor of the improvements which he now claims.

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2. *The Carhart Bellows substantially the same as those having "Tube" connections.*

In view of the first claim in Carhart's second reissue, it becomes necessary to inquire whether or not a bellows composed of an exhaust and exhausting chambers, so constructed that the stationary leaf or board containing the reeds forms a substantial part of the cover of the exhaust chamber, the exhaust and exhausting chamber being separated by a board with perforations, is in principle of construction and operation, *substantially the same* as a bellows composed of similar chambers, and covered in a substantial part by the reed-board—the chambers being connected by tubes instead of perforations. To prove the affirmative of the question, we rely on the testimony of the experts.

(*a*) Renwick, expert for complainants, attempts to show that there is such a difference in principle in the construction of the two devices; and he speaks of that different construction as an "invention," but does not positively assert it to be one. See his testimony, Ev., p. 91, Int. 10. And Renwick limits the first claim to the *connection* of the *reeds* with the *exhaust chamber*, when the exhausting chamber is connected with the former *without the intervention of tubes*. See Ev., p. 92, Int. 13. And he can see no musical results; only a difference in mechanical construction. See Ev., p. 93, Int. 15.

But Renwick is contradicted by every other expert. They all affirm that there is no difference in the principle of construction and operation of the two devices, nor in the musical effects produced by them, except it may be that the bellows, which embodies the tube connection, produces the best results.

In relation to the principle involved in the mechanical construction and operation of the two descriptions of bellows, the following experts say that it is the same in both the Carhart and in the instruments having bellows with tube connections, namely: Robert H. Eddy, Ev., p. 197, Int. 21, 22; Geo. D. B. Prescott, Ev., p. 161, Int. 12, 13, 14, 15, 16, 17, 18, 20, 21, 22; Joseph W. Prescott, Ev. 173, Int. 6, 8, 9; David M. Dearborn, Ev., p. 179, Int. 4 to 8; Abraham J. Prescott, Ev., p. 188, Int. 9, 10, 13, 14, 15; and Joseph S. Clark, complainant's witness, Ev., p. 225, Int. 8, 9, 10. And in relation to the *musical effects* produced, the experts all concur. See Geo. D. B. Prescott, Ev., p. 160–1, Int. 9, 10, 11; David M. Dearborn, Ev., p. 181, Int. 12, 13; John H. Morey, Ev. 183–4, Int. 3, 4, 5, 6, 7; William A. Hodgdon, Ev., p. 186, Int. 8, 9, 10, 11; Abraham J. Prescott, Ev., p. 187–8, Int. 3, 4, 5, 6, 7, 8. *These witnesses stand uncontradicted*, and Mr. Austin concurs in these opinions, both with respect to the principle involved and the musical effects produced. See Ev., p. 152, Int. 12, 13, 14, 15, 16, 17, 18, 19, 20.

The preponderance of testimony is overwhelming. Therefore, the deduction from the evidence is, indisputably, that the bellows

And it may be here remarked that the combination covered by the first column in Carhartt's second re-issue patent, is not the same as that in the "French" Melodeon. In the latter the combination embraces the reed, reed seats, reed-cells, and bellows. That combination existed in the "French" instrument long before Carhartt thought of reed-cells - namely, in 1839. The instrument with reed-cells was finished long after his abortive experiments with the bellows, in 1839 - namely, in 1846. The "Knowles" instrument was the first of Carhartt's to attract that degree of notice.

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with tube connections, and that in the Carhart instruments are substantially the same in principle of construction and operation, and produce the same musical results. And the further deduction results, *that Carhart is not the first inventor of the device covered by his first claim;* the same substantially existing in the old "Fowle" instrument, which is proved to have existed 46 years at least, namely, since 1818—*twenty years* before Carhart even made an experiment upon reed instruments with a view to their improvement. See deposition of Miriam C. Fowle, Ev., p. 147, and deposition of Samuel L. Fowle, Ev., p. 149. And also existing in the "French" instrument in the spring of 1839, *six years* or more before Carhart ever produced an operating instrument.

The advantage of *compactness*, claimed for Carhart's instrument by John G. Pearson, is not one of invention, but of construction. Besides, the "Fowle" instrument is as compact as one constructed with a bellows underneath, like the "Wing" and Patent Office models, which represent Carhart's *first* arrangement of the bellows.

But if the "Fowle" instrument does not contain all the devices and combinations claimed by Carhart in his last re-issue, *the "French" instrument does*, except the concentrating chamber, and therefore it becomes necessary to settle the question of priority between the French instrument and Carhart's.

In order to determine this question of priority it becomes necessary to trace the history of improvements alleged to have been made by both French and Carhart.

3. *History of the Invention by Carhart.*

Carhart commenced experiments on the accordeon in the winter of 1837–8, to see if he could make a *suction bellows*. See Jeremiah Carhart's dep., Ev., p. 63, Int. 5, 6, 7. The *result not satisfactory*. Six or nine months after, he applied the same mode of operation to the melodeon which is represented in the "Wing" model. It was simply the application of the bellows. It was the suction draft of the accordeon, applied to the melodeon, producing the same result. No reed-cells nor concentrating chamber in this. See his dep., Ev., p. 64, Int. 19, 20, 21, 22, 23.

In May, 1839, Carhart explained this improvement to John G. Wing. See Wing's dep., Ev., p. 40, 41, Int. 9, 10, 11, 12 and 15.

In 1838 or 1839 he showed the same thing to Frederick Oliver. See Ev., p. 50., Int. 9, 10, 11 and 12.

The improvement was in converting it from a *blowing* to a *suction* bellows. See Ev., p. 50, Int. 13.

Before the 15th of April, 1839, and before he got married, Alfred G. Badger saw the accordeon altered from a blowing to a suction bellows. See Ev., p. 56, 57, Int. 10, 15 to 18. And he next saw the suction bellows applied to some kind of melodeon. See Ev., p. 57, Int. 19. He says the "Wing" model represents

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Carhart finally says he altered the melodeon, as appears in the "Wing" model, "in August or September, 1839." See Ev., p. 70, Int. 63–65. This is the substance of the testimony showing the operations of Carhart, which resulted in producing the devices represented in the "Wing" model. *It was produced in August or September*, 1839. The change which he alleges he made, was in reversing the structure of the bellows. See Ev., p. 65, Int. 23.

In 1846, seven years after, he says he became connected with Mr. Needham, in the manufacture of the melodeon, which, he says, he "finally invented after *many years*." See Ev., p. 67, Int. 36, 37.

After he left Nichols & Badger he got up one large instrument and several small ones, operating in the same manner, as shown in the "Wing" model.

In the winter of 1839–40 he says: "I commenced the large one I speak of. That took me a good deal of time to build. I was some two years in making that, I suppose." See Ev., p. 67, Int. 39, 40, 41. That would bring its completion down to the winter of 1841–2, and up to this time it does not appear that he had invented what he now claims in his last reissue patent.

On cross-examination, Carhart says that the instruments made by him from the time of his leaving Nichols & Badger, in 1840, to the time of his taking his patent, (December 28, 1846,) except some made in 184[illegible], were destroyed, including the large one. See Ev., p. 68, Int. 47, 48, 49.

Thus it appears *that no successful operating instrument was produced by him until* 1846.

He says all the instruments made and sold by him prior to his reissue of 1857 contained the "tube-board," that is, the reed-cells. He does not say a word about the "concentrating chamber." See Ev., p. 69, Int. 55, 56.

He does not know when the "Wing" model was made, but it was altered last November (1863) he thinks. See Ev., p. 69, and Int. 58. He says it is the *fac simile* of the melodeon altered in 1839. It was altered under his directions. See Ev., Int. 25 to 28, p. 66. He says the instrument he gave to Knowles he made in Buffalo, and carried it to Washington in 1846. See Ev., p. 72, Int. 75. *That was the first appearance of any instrument made by Carhart containing all the devices claimed by him in his re-issue of August* 18, 1857, *except the concentrating chamber, which appears to be absent in the Knowles instrument.* #

And Carhart adds the remarkable statement, that the instruments made by him between the time he left Nichols & Badger, in 1840, and the time he applied for a patent, in 1846, were

What is the "concentrating chamber?" The drawings of the second re-issue patent show that it is a mere space divided by a partition in the upper part of the instrument behind the reeds. It is not a "small chamber", like that in the "French" instrument, and in all modern instruments, designed to increase or diminish the sound.

destroyed because he did not consider them worth much. See Ev., p. 72, Int. 80, 81, 82.

The substance of the testimony of Carhart on the point of priority of invention is, that he did not produce a successfully operating instrument, with all the improvements claimed in his reissue of August 18, 1857, until some time in 1846—admitting that the Knowles instrument contained the concentrating chamber. But that is denied, (see dep. of R. H. Eddy, Ev., p. 196, Int. 19,) notwithstanding the testimony of Hazard Knowles and James B. Donelan, who speak of a concentrating chamber *after having drawings representing it placed in their hands*, and having written and oral communications with the complainants' counsel. Testimony taken under such circumstances will be received with great caution. #

A History of the invention by Parmelee

The "Mig" model could not have contained in 1839, the devices now claimed in Carhart's reissue No 118. It was returned to Knobel & Badger, and although back was a rocking melodeon. See Carhart's Ans. Int. 28, 29. Badger's Int. 14. 15.

reed-cells in relation to the reeds. In the Carhart instrument they are all arranged in one way, the tongues all pointing inward towards the end of the cell; whereas, in the "French" instrument, the tongues point inward and outward in reference to the opening of the cell. This difference, they contend, is a material one, and patentable in view of the arrangement of the cells in the "French" instrument. And in support of this position, they rely on the cases of Hussey *vs.* Bradley, and ~~Roonin~~ Ransom *vs.* Mayor *et ali.* decided in the second circuit of New York, Law's Dig., p. 422.

It is contended that the present case is unlike that of Hussey *vs.* Bradley. In the Hussey machine, a mower, the blades are all arranged one way, that is, with the ~~flanch~~ edge uppermost. In the machine alleged to contain the same device, they are arranged alternately, with the ~~flanch~~ edge uppermost and undermost; whereas, in the "French" instrument, all the base reeds in reference to the cells point outward, and all the reeds giving the higher notes point inward, in relation to the openings of the cells

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4 *History of the invention by French.*

The "French" instrument contains all the devices or combinations contained in the Carhart instrument, with the exception of the alleged concentrating chamber. For this concentrating chamber a *swell-chamber* is substituted, which is a different and better device, inasmuch as it enables the performer to increase or diminish the volume of sound at pleasure.

Such is the testimony of all the experts. (See R. H. Eddy Dep. Ev., p. 198, Int. 28.) They are however mistaken in the fact that the "French," instrument contains this concentrating chamber, as a comparison of the instruments exhibited in this case will show. They mistook the swell, for the concentrating chamber.

The complainants admitted in the argument of their counsel in the court below that the Carhart and "French" instruments are similar, save in one respect, namely, the arrangement of the reed-cells in relation to the reeds. In the Carhart instrument they are all arranged in one way, the tongues all pointing inward towards the end of the cell; whereas, in the "French" instrument, the tongues point inward and outward in reference to the opening of the cell. This difference, they contend, is a material one, and patentable in view of the arrangement of the cells in the "French" instrument. And in support of this position, they rely on the cases of Hussey *vs.* Bradley, and ~~Roonin~~ Ransom *vs.* Mayor *et ali.* decided in the second circuit of New York, Law's Dig., p. 422.

It is contended that the present case is unlike that of Hussey *vs.* Bradley. In the Hussey machine (a mower, the blades are all arranged one way, that is, with the ~~flanch~~ edge uppermost. In the machine alleged to contain the same device, they are arranged alternately, with the ~~flanch~~ edge uppermost and undermost; whereas, in the "French" instrument, all the base reeds in reference to the cells point outward, and all the reeds giving the higher notes point inward. in relation to the openings of the cells

There must, of course, have been a reason in the mind of French for this arrangement. It implies that all the reeds had been *once* pointed one way in reference to the cells, but for some good reason, were rearranged, a part being made to point inward, and part outwards. Having the reeds in one portion of the reed-board, all pointing one way, and in another portion all pointing the other way, conclusively proves that French thoroughly understood the effect of arranging them so as to have all point in the same direction in relation to the reed-cells. Merely changing the direction of one portion of the reed-cells, in relation to the reeds, could not involve invention. In view of the "French" instrument, it was a mere mechanical act, requiring no exercise of the inventive faculty. The invention was complete when a single cell was constructed with the reed which it contained pointing inwards; and the arranging of one or one hundred afterwards in the same way, was but a repetition of the first, and was no invention. #

To return to the question of priority: ~~Such is the testimony of all the experts, and the fact is not denied by the complainants. (See R. H. Eddy, Ev., p. 198, Int. 28.)~~

The "French" instrument is proved to have been made by the defendant, and sold to George L. French, December 15, 1838. (See Charles Austin's deposition, Ev., p. 150, Int. 3, 4, and 11, also George W. French, Ev., p. 136, Int. 12, and bill of sale annexed.) The sale was on December 15, 1838. It had then a blow-bellows. In the winter and spring of 1839, French altered it from a blow to a suction bellows, and introduced reed-cells and swell chamber, as it now is. This fact is proved by the following witnesses: Mrs. Matilda French, George W. French, and John F. Carney.

1st. Mrs. French says her husband was "a very skillful mechanic, and accustomed to manufacturing and repairing musical instruments of various sorts." (See Ev., Aff., p. 133.) That her husband made the alterations in the instrument as now shown, within five or six months after he purchased it, which must have been in the first half of 1839. See Ev., p. 129, Int. 6, 7, and 17. The instrument in evidence is the same, and has not since been altered. See Ev., p. 129, Int. 8. As a reason why she remembers the fact, she says she was loath to have it done. Ev., p. 131. Int. 17. And in 1840 she moved from Lawrence to Merrimack street. Ev., p. 131, Int. 19. It was done before her removal.

2d. George W. French says his father had the instrument in 1839, and made the alterations within six months after. See Ev., p. 134, Int. 2. He was then (correcting his testimony) between six and seven years of age. See Ev., p. 139, Int. 26. That he remembers the fact by the circumstance of putting his fingers in the valve when persons were playing (Ev., Int. 7), by hard words between his father and mother, and being himself whip-

Besides, the pouring of the reeds, inward, or outward, into either of the openings of the cells, is no part of the claims set up in Coolidge's second reissue patent of Aug. 18, 1857. None of claims in any of the patents either one specific device, or an element of a combination.

ped for his mischief (Ev., Int. 15 and 17); that his father commenced the alterations in two or three months after purchasing the instrument (see Ev., p. 138, Int. 27); that the reeds and cells are the same now as then (see Ev., Int. 10 and 11); that he commenced to play himself when he was fourteen (see Ev., Int. 9.) He describes the instrument. See Ev., Int. 4, 5, and 6. He found the bill of sale in October or November of 1863. See Ev., p. 136, Int. 12. In his affidavit he says his father bought the instrument in December, 1839 (Ev., p. 139); that was given before the discovery of the bill of sale. It shows he was mistaken one year. But without the bill of sale, he remembered the month precisely.

The bill of sale precisely proves the date of the sale of the "French" instrument by Austin to French. It was December 15, 1838. See Ev., p. 136, Int. 12.

The Court is respectfully referred to the affidavits of Matilda French, Ev., p. 133, and of George W. French, Ev., p. 139. In those affidavits, taken before any testimony touching the date of the invention had been taken, the affiants testify that George L. French made the alterations in the "French" melodeon, as they now appear, the year after he purchased the invention of Carhart. The evidence shows that it was within six months after the purchase, and therefore in the first half of 1839.

3d. John F. Carney testifies that he is a musician by profession; that he examined the "French" instrument in the spring of 1839, and the instrument before the court is the same as it then was. See Ev., p. 141, Int. 3 and 4. In his answers to Int. 5, 6, 7, 8, 9, and 10, he describes the improvements made by French. He thinks the accordeon must have suggested the alterations to French. See Ev., Int. 11. He has been a music teacher twenty-three years, and plays the piano, violin, harp, and organ. See Ev., Int. 12. On cross-examination he says he went to examine the instrument at the request of French (see Ev., Int. 20); that French showed him how he had altered the instrument, reeds, cells, and bellows. See Ev., Int. 26 and 27. He says he knows it was in 1839, because he traveled with a circus exhibition in 1838; got back to Lowell in the latter part of 1838, and it was the next spring after. See Ev., Int. 40, 42. And he knows it was the next spring after he got back, because all of that winter and spring following he was out of business. See Ev., Int. 44. The next winter and spring, a year after (1840), he was engaged in the Lowell Museum. (Not in 1839.) Ev., Int. 45. These circumstances show the correctness and reliability of the witness.

The irresistible conclusion, therefore, from the evidence is, that the "French" instrument, with all the improvements it now contains, *was in existence in the spring of* 1839, seven years before the existence of any instrument produced by Carhart, having the

same improvements, and, therefore, is prior in invention to the last named instrument.

The two instruments relied upon by the defendant, namely, the "Fowle" and "French" melodeons, having both been produced prior to the alleged invention by Carhart, claimed in his reissue of August 18, 1857, establish the fact that Carhart is not the first and original inventor of any of the improvements claimed by him.

5. *Chronological History of the Instruments.*

The facts proved in this case establish the following dates with regard to the production of the several instruments involved, namely:

In 1818, the "Fowle" instrument is proved to be in existence.

In 1837–'9, Carhart commenced his experiments on accordeons and melodeons, but produced nothing practicable till 1846.

In 1839, in the winter and spring, George L. French produced the instrument known as the "French" instrument, marked R. H. E., full and complete, as it now is, and containing all the improvements covered by Carhart's reissue of August 18, 1857, except the concentrating chamber.

In 1846, Carhart produced the instrument given by him to Hazard Knowles, which is the first instrument ever produced by him containing the improvements set forth and claimed by him in his reissue of August 18, 1857, except, probably, the concentrating chamber; and the Court will notice that Carhart cannot find, and has not produced, *any earlier* instrument of his manufacture.

In 1863, the "Wing" model, altered by Carhart from an old rocking melodeon, was produced.

6. *Chronological History of the Patents.*

And the facts proved establish, also, the following chronological history of the several patents taken out by Carhart, in relation to his alleged invention, namely:

1846, December 28. He obtains his original letters patent, claiming only an improvement *in the bellows;* his model, drawings, and description, representing and claiming only that improvement.

1856, June 24. He surrenders his original patent, and takes out his first new and corrected patent, in which he claims, not the improved bellows, but a combination of reeds with the exhaust and exhausting bellows.

About this time he has an unsuccessful lawsuit with Mason & Hamlin, and learns by that experiment that neither his original patent, nor first reissue, cover anything patentable.

1857, August 18. Having been defeated in his claims by Ma-

son & Hamlin, he again surrenders his second patent, and takes out his third, under which he now claims.

And now appears, for the first time, his claim to the reed-cells and concentrating chamber, not as distinct and separate improvements, but in combination with the reed-seats and suction bellows.

And now appears a new drawing, which, for the first time, represents the reed-cells and concentrating chamber, being figure 5 of the drawings attached to the reissue of August 18, 1857.

The simple statement of these facts, namely, the dates of the instruments and patents, must show to any honest mind that Carhart's present claims are unfounded and fraudulent.

7. *Miscellaneous Matters.*

1. *The Accordeon.* But if more proof were wanted to show the invalidity of the claims of Carhart, it is only necessary to refer to the accordeon to find it. That instrument, before Carhart ever contemplated an improvement in reed instruments, contained a combination of reed-seats, reed-cells, and an exhaust bellows. It contained both the blow and suction principles. Carhart, according to his own testimony, took his idea of a suction bellows from that instrument. It was the first instrument he experimented upon. Carney thinks French took his idea from the same instrument.

The accordeon contains not only a suction-bellows, but reeds with cells over them, and of course reed-seats. See Ev., John G. Pearson, p. 213, and. Int. 34, 35, and Int. 47–56, p. 218. It contains one cell with two reeds, and fifteen cells with one reed each, and was made in 1840 as now. See Pearson's testimony.

2. *What constitutes Invention?* Relying on the case of Hussey *vs.* Bradley, the counsel for complainants in the court below, defined invention, such as our laws are intended to protect, to be "the adaptation of means to ends in the useful arts." There must be a conception of an object to be accomplished, and the contrivance of a way to accomplish it.

The last clause of this definition is not strictly true. It is not necessary to invention that there should be a prior conception of the object to be attained. Invention may be entirely accidental, may be made by endeavoring to attain an object entirely different from the object discovered. This is often the case in processes, and may be in mechanism. Whether discovered by long thought, experiment, creative genius, or mere accident, a new creation or improvement in processes, manufactures, or mechanism, is the property of the first discoverer or inventor, and entitled to the protection of the law.

3. *Improvements in the elements or details of a combination can only be claimed.* If an improvement is made in any element, or any one device or group of devices, constituting a combination,

that specific improvement can only be claimed, and not the combination thus improved. The patentee can claim no more than he has invented; his specification must describe, and his claim point out, the precise thing which he has invented, or the improvement which he has made. See Whittemore *vs.* Cutter, 1 Galli., 478.

If Carhart had invented an improvement in the bellows, he can claim that only. If he had made one in the reeds, or cells, he could claim that only. He can claim the *improvement* only, not the combination with the improvement in it. These are submitted as sound principles of patent law.

8. *Carhart is the Inventor of Nothing.*

But, Carhart has in fact invented nothing—not a single device separately described by him in all his specifications—nor a single combination which he attempts to cover and secure in his second reissue. The *suction bellows*, which was the only thing he first supposed and believed he had invented, existed at least twenty years before he ever dreamed of it. The combination of reed-seats and reed-cells—the latter always going with the former when used at all—existed long before he ever thought of them.

The reed-cells or "tube board," as Carhart in one of his specifications calls them, are an important part of the mechanism of the modern melodeon, constituting a great improvement in the instrument. Yet, Carhart is not the inventor of this combination, nor of either of its elements. He claims the combination only when used with a suction bellows. If he had been the inventor of that combination, or of either of the devices constituting it, the reed-seats or reed-cells, would he not secure them by letters patent, claiming them specifically? And so of all the other parts of the melodeon which he attempts to cover by his second reissue, if he had invented them. The fact is, he has not invented and does not specifically claim one of them.

But in his reissue of August 18, 1867, he has fraudulently attempted to cover and appropriate to himself all the essential parts of the instrument, and thus to secure a monopoly of its manufacture. His three specifications taken together show this intent. That his furtive and nefarious purpose will be defeated by the decision of this honorable tribunal, cannot for a moment be doubted.

The evil and dangerous practice of surrendering patents and taking out reissues which cover what the patentee had never invented, and thus insidiously and stealthily encroaching upon and appropriating the rights of other inventors and of the public—a practice, I regret to say, now too prevalent—should be frowned upon by courts of justice. And for the cause of justice I rejoice at the sound and enlightened views expressed by this

tribunal in the case of Burr *vs.* Duryee, before cited, in relation to the reprehensible practice referred to.

In this connection, the court is respectfully requested to examine and compare the specifications attached to the three different letters patent taken out by Carhart, and introduced as exhibits in this case.

9. *Modern Improvements in Melodeons.*

The improvements in modern melodeons, their cheapness, and the demand for them, have resulted from various causes. One of the most important of those improvements is in "*voicing the reeds.*" The art of voicing the reeds has greatly improved the tones of the reeds, and made them more pleasing to the ear. See dep. of George B. Prescott, Ev., p. 168, Int. 60, 66. It has made the melodeon approximate nearer to the organ, and therefore more in public demand. And improvements in machinery and processes of manufacture are another cause of their greater cheapness and demand. John G. Pearson, witness for the complainants, is obliged to admit these facts. In his answer (Int. 37, p. 213, Ev.) he says of the voicing of the reeds, "*there had been a marked improvement,* and that the tendency of such was to increase the production and popularity of the instrument." #

The tone of the reeds is also improved by "suction," which Carhart originally claimed but abandoned. See Joseph S. Clark's dep., Ev., p. 225, Int. 9. And for improvements in machinery and manufacture, see Pearson's dep., Ev., p. 210–11, and 21 to 27.

These facts are a full reply to his testimony as to the market demand of the instrument having been increased by Carhart's alleged improvements; but such testimony is not competent to prove the fact of invention or priority. The same objection exists to the testimony of Joseph S. Clark.

And in this connection it may be remarked, that although in the "French" instrument the exhausting bellows was, so far back as 1839, placed above the reed-board and behind the reeds, as now used in all such instruments, in the Carhart instruments the exhausting and exhaust bellows were both placed underneath the reed-board as in the Patent Office and "Wing" models, the exhausting bellows not being placed *above* the reed-board and behind the reeds until sometime after the issue of the the original letters patent to Carhart. In fact the whole arrangement of bellows and reed-board as now used, and claimed in the second reissue, and which is to be found in the "French" instrument, was not made until after the issue of the original patent. See Pearson's dep., Ev., p. 209–10, Int. 18, 20.

And this arrangement is claimed as an important improvement in the melodeon, giving it compactness of form, if that be a patentable improvement. It is, however, the work of the mechanic, involving no invention.

[4] See Pearson's testimony. Ev. p. 208-9 Cross. Int. 9. "He [illegible] as a result of experiments on instruments with old fashioned reeds. He [illegible] he was with the reeds."

10. *Melodeons with Tube Connections are not New.*

Pearson also states that he has repaired suction bellows with tube connections, long before the introduction of Carhart's bellows. See Ev., p. 209, Int. 14. They were nearly of the same principle of the Carhart bellows, (see Ev., p. 209, Int. 15, 16,) and the workmanship poor, (Int. 17.)

Joseph S. Clark has also repaired those old instruments, with tube connections on the suction principle. See Ev., p. 220–21, Int. 7 to 11. He says the principle and mode of operation of the tube and Carhart instrument are the same, namely, the suction. See Ev., p. 225, Int. 8, 9, 10.

Harmoniums have bellows with tube connections. See Ev., p. 221–22, Int. 14, 15.

The Prescotts say the same. See the deposition of Geo. D. B. Prescott, Ev., p. 169, Int. 73, 74, 75, 81; deposition of Joseph W. Prescott. Ev., p. 176, Int, 18, 19, 20, 21.

It is assumed by the complainants that the arrangement claimed by Carhart, by which he supersedes the use of wind-chests and tubes, expedites the speaking of the reeds, and improves the tone of the instrument.

This assumption is not sustained by the facts proved in this case. In the instrument known as the harmonium, the largest of the melodeon class, which approximates nearest to the organ in power and perfection of tone, and is designed for church use, tubes and wind-chests are employed, and actually improve the instrument. See dep. of George D. B. Prescott, Ev., p. 169, Int. 73 to 82 inclusive; dep. of Joseph W. Prescott, Ev., p. 176, Int, 18, 19, 20, 21; dep. of Joseph S. Clark, Ev., p. 221, Int. 14, 15.

In view of the evidence on this point, it is contended that neither reeds nor wind-chests change the principle of the melodeon as now constructed, nor prevent the prompt speaking of the reeds, nor injure the tone; thus disproving the mere advantage alleged in the first claim of Carhart's second reissue, and contended for in argument by the counsel for the complainants.

CONCLUSION.

From the facts and the law, therefore, it appears to be clear that the complainants are not entitled to recover in this proceeding, and that the bill of complaint should be dismissed, with costs to the defendant.

EDMUND BURKE,

Solicitor and Counsel for the Defendant in Error.

APPENDIX.

OPINION OF JUDGE CLIFFORD, DELIVERED IN THE CIRCUIT COURT FOR THE MASSACHUSETTS DISTRICT, AND REFERRED TO IN THE PENDING ARGUMENT.

JEREMIAH CARHART AND AL., in Equity, *vs.* CHARLES AUSTIN.

Suit in this case was brought by the complainants to recover damages of the respondent, for the alleged infringement of certain letters patent. Invention, as described in the patent on which the suit is founded, is for a new and useful improvement in reed musical instruments, which is the second reissue. Original patent, dated the 28th day of December, 1846, was for a new and useful improvement in bellows for musical instruments, and such was the description of the invention as contained in the specification. Patentee is the first named complainant, and the record shows that he, on the 24th day of June, 1856, surrendered the patent, and the same was reissued to him on an extended specification. General description of the invention in the first reissue is the same as that on the original patent, but the statements of the specification as to the characteristics and objects of the invention are greatly changed. Reason for the surrender and reissue, as alleged in the bill of complaint, was that the original letters-patent were inoperative, on account of a defective and insufficient description and specification, arising out of inadvertency and mistake. Second surrender was also made for the same reason; and on the 18th day of August, 1857, the patent was reissued to the patentee for a second time. Amendments made to this specification, as appears by the record, were extensive and radical. Term of the patent, as originally granted, was for fourteen years; but the last reissue was, on the 24th day of December, 1860, extended by the Commissioner for the further term of seven years from and after the termination of the first term. Title of the complainants was derived from the patentee, and is not the subject of controversy in this suit. Defences set up by the respondent in the answer, and pressed at the argument, are the following: 1. That the last reissued patent is void, because it is for a new and different invention from that set forth in the original patent. 2. That the patentee was not the original and first inventor of the alleged improvement. 3. That the claims of the patent are insufficient to cover any combination or invention, and that the patent therefore is void. 4. That the improvements claimed in the last reissue were abandoned by the inventor, and are forfeited to the public use.

1. First question presented involves the necessity of a careful examination of the specifications and claims of the several patents to which reference has been made. Specification annexed to the original patent describes the invention, not in the words employed in the patent itself, but as new and useful improvements in the bellows of that class of musical instruments called melodeons, seraphines, and æolian attachments. Prior to the invention of the patentee, as he states, in all instruments in which reeds were vibrated by a current or currents of air, the bellows was so constructed as to blow or force the current against the reeds, instead of drawing the current by an exhausting action of the bellows, as in

his method. Defects of the old method are very clearly pointed out in the specification, and it is shown very satisfactorily that these defects produced irregular tones, and of course diminished the value of the instrument. Tones in such instruments are regulated by the force of the current by which they are produced; and the patentee states that the objects of his invention are to produce a constant current of regular force, except when it is required to be increased to produce the swell, and so to arrange the parts as to occupy less room than by the modes heretofore practiced. Detailed statement is then given of the means the patentee employs to effect those objects. Referring to that statement, it will be seen that he makes the bellows with two exhausting chambers, constructed, arranged, and operated as therein circumstantially described. Inventor further states that his invention also consists in making the valves of the flap by means of a piece or pieces of thin leather, or other like material, drawn over a hole, or series of holes, and that the leather so placed is prevented from flapping, when stretched by use, by the means of a strip of india-rubber over the middle of the valve. Particular description is also given of the drawing, then follows a very elaborate explanation of the invention, which need not be reproduced. Principal claim of the patent is, "Making an exhausting bellows for reed instruments, consisting of two chambers, combined with each other and with reeds placed above, so that the chamber next the sounding-board shall be enlarged by a weight on the first flap and exhausted by the action of the second flap, substantially as described." Claim is also made in the patent for the method of making the valves by means of strips of leather or other material having like properties, as described in the specification. Such was the description of the invention, as more fully set forth in the original specification, but new matters of very great importance are introduced into the amended specification of the second reissue, on which the suit is founded. Patentee states, in the outset, that the object of his invention is to improve the tone of the reeds, and to impart to them promptness and certainty in responding to the touch of the keys, and at the same time to give a compact and convenient and graceful form to the instrument. Radical change is also made in the description of the defects which existed in the instruments constructed prior to his invention. Some parts of the reeds, as the patentee now states, were uniformly found to be slow in speaking, and would often fail entirely, that is, they would either not speak at all or would give their tones out of tune. Sound of the reeds also was *disagreeable and nasal* to such a degree that the instruments could not be extensively introduced. Most radical change, however, is incorporated into the description of the construction and mode of operation of the instrument. Bellows, it is said, operate by exhaustion, and is constructed with two chambers, the one drawing the air from the other—the first having a tendency, by weight or springs, to expand with a force equal to about seven pounds to the square foot, and the other tending, by similar means, to close, so as to expel the air within it. Upper leaf of the exhaust chamber is as the representation is firmly attached to the frame of the instrument, a little below the key-frame. Openings for the reeds are made through that board, and directly over each reed-seat is a cap, closely fitting upon the reed-board, forming a cell over the reed and reed openings, about the length of the reed. And the statement is, that this case is open at one end of the reed, and closed at the other, and is in width and in depth about three-eights of an inch, but should be slightly increased for the large reeds, and diminished for the small ones. Continuing the description, the patentee states that about three inches from the mouth of the reed cells, and on the same leaf of the exhaust chamber, he places a board in a vertical position, which he calls the concentrating board, and, as described, it extends to the ends and top of the instrument, thus forming a narrow chamber, open substantially at the top, but extending the whole length of the reed-board. Emphatic statement of the patentee is, that by the use of these *cells on his bellows* the tone of the reeds is greatly improved, and their speaking greatly accelerated, and that the concentrating chamber also much increases in richness. Whether new or old, it can not be doubted that the improvements described may have a tendency to

improve the tone and increase its richness—but the difficulty in the case is that neither of them were described, suggested or indicated in the specifications or drawings of the original patent. They are not amendments, but interpolations of the boldest and most unmistakable character, unsupported by any thing to be found in the original patent, or even in the first reissue, as will more fully appear by attention to the claim of that patent. Undoubtedly the patentee made some advance in the work of expansion when he framed that specification, but the claim of the patent is altogether too narrow to support his present pretensions. As there stated, the claim is the combination of the reeds with an exhaust chamber of variable capacity and an air pump, whose action exhausts and rarefies the air therein, the exhaust chamber tending to expand with a force that will balance the rarification to be preserved in the chamber for the purposes herein set forth. Reference is made to that claim merely to show the process of expansion, and the steps by which it was accomplished. Widely as that claim differs from the claims in the original patent, still the difference is incomparably less than it is when the comparison is made between the claim of the original patent and those contained in the last reissue, on which the suit is founded. Last reissued patent has three claims, as follows: First claim is so connecting the board which contains the reed seats, or perforation for the reeds, with the exhausting bellows, that it shall form substantially a part of the stationary leaf or cover of the exhaust chamber thereof while the exhausting or pumping chamber is placed in immediate connection with the exhaust chamber, without the intervention of tubes; thus improving the tone of the reeds and expediting their speaking, and giving a compact, light and graceful form to the instrument, substantially as described. Secondly, the patentee claims the reed-cells, in combination with the reed seats or openings, substantially as described. Thirdly, he claims the concentrating chamber, in combination with the reed-cells and reed seats, substantially as described; but he claims the last two combinations *only* when they are to be used with suction or exhaust bellows, capable of producing a continuous current of air through the reed openings. Doubtless there is some trace of the invention, as described in the original patent, to be seen in the first claim, and yet it is obviously founded chiefly upon the interpolations contained in the specification of the last reissue, and the descriptive part is so mixed up with these new matters that it is impossible to separate the one from the other, and consequently the whole must stand or fall together. Better opinion is, that where a patent contains several claims, and the invention covered by one of them is not new or absolutely void, the patentee may maintain an action for the infringement of the patent, so far as it regards the valid claims, although he did not make or record a disclaimer of the invalid or void claim before the commencement of the action. (Hall *vs.* Mills, 2 Blatch. C. C. Rep., 194; Vance *vs.* Campbell, 1 Black., 429.) But the principle cannot be applied to this case, if it be true that a patentee cannot embrace in his reissued patent any patentable improvements not described, suggested or indicated in the specification or drawings of his original patent, because it is evident that even the first claim is mainly founded upon such new matters, and that those new matters are so interwoven with the descriptive portion of the claim that they cannot be separated from the other matters therein described, which correspond more nearly with the elements specified in the original patent.

Complainants admit that the second and third claims are founded entirely upon these interpolations, and the admission is a very proper one, as the fact is so beyond all controversy. Admission in the brief of the complainants is, that "neither in the specification, drawing, or model filed and remaining in the Patent Office, as a part of the original application, do the devices covered by" those claims appear. Their position, however, is that his invention, as originally made, did, as a matter of fact, embrace those devices; and they insist that the Commissioner of Patents, pending an application for reissue, may hear parol proofs as to what the invention was, and may allow the applicant so to amend his specification, and the claims of his patent, as to embrace everything

which the proofs show that he actually invented, notwithstanding the reissue may include improvements neither described, suggested or indicated in the original model, application, specification or drawings. Theory of the complainants in fact is, that the decision of the Commissioner, except in cases of actual fraud, is conclusive that the new improvements described in the amended specification and included in the claims of the reissued patent were a substantive part of the invention secured in the original patent.

Whenever any patent * * shall be inoperative or invalid, by reason of a defective or insufficient description or specification, * * if the error has arisen by inadvertency, accident, or mistake, and without any fraudulent or deceptive intention, it shall be lawful for the Commissioner, upon the surrender to him of such patent, and the payment to him of a certain duty, to cause a new patent to be issued to him, *for the same invention*, for the residue of the period then unexpired, for which the original patent was granted. (5 Statutes Large, sec. 13, p. 122.) Proposition maintained by the complainants is, that the applicant for a reissue may offer parol proofs to show what his invention was, and that the decision of the Commissioner, whatever it may be, is conclusive, except in cases of fraud. Support to that proposition is chiefly drawn from the case of Stimpson *vs.* Westchester R. R. Co., 4 How. 404, and it must be admitted that there are some remarks in the opinion of the court which give some countenance to that view of the law. Those remarks, however, were not necessary to the decision of the cause, and they must be received with some qualification, as the express requirement of the act of Congress is, that the reissue must be made for the same invention. Unless the reissue is for the same invention, the Commissioner has no power to grant it; and it cannot be maintained for a moment that the decision of the Commissioner is conclusive as to his own jurisdiction. Patent in that case was for an invention or improvement in the application of the flanches of the wheels on one side of railroad carriages, and of the treads of the wheels on the other side, to turn short curves upon railroads. Specifications of the patent being defective, it was surrendered and reissued in order, as proved, to limit it, and confine it to the turning of short curves in streets. Original patent was burnt with the Patent Office, and no part of the specification was preserved, except what was published in a certain journal. Principle defect in the original patent was in regard to the grooves, and the witness called to prove the contents of the original patent testified that he thought that the grooves were alluded to in the original specification. Instructions of the court to the jury were, that the use of the grooves, which were described as a part of the invention of the reissued patent, was no part of the thing originally patented. Remarking upon that part of the charge, the Court say: Whether the new patent was substantially for a different invention from the first one, was a question for the jury, on the evidence; and there can be no doubt that the rule as stated was correct, as applied to that case. Error of the judge at that trial was in ruling as law what, under the circumstances of the case, belonged to the jury. But the rule is otherwise, if it appears on the face of the two patents by comparison that the reissue is for a different invention from that secured in the original patent. Such was the ruling of this court in the case of Sickles *vs.* Corliss, Mass. Dis., 186 , Oct. T., and in the case of Goodyear *vs.* The Prov. Rubber Co., R. I. Dec., Nov. T. 1864, and I must adhere to that opinion until the question is otherwise settled by the Supreme Court. Commissioner in the case of the burnt patent had something to amend by, if the witness was to be believed, and surely it was the duty of the Court, under those circumstances, to submit the question to the jury, whether the original patent was or was not for the same invention. Neither the Court nor bar pretended in that case that the decision of the Commissioner was conclusive, but the question was whether the decision belonged to the Court or Jury. Opinion of the Court was delivered by the same Judge in the case of Battin and al. *vs.* Taggart and al., 17 How. 83, which was decided eight years later; Supreme Court say in that case that the reissued patent must be for the same invention, substantially, though it be described in terms more

precise than in the first patent. Under such circumstances, a new and different invention cannot be claimed. But where the specification or claim is made so vaguely as to be inoperative and invalid, yet an amendment may give to it validity, and protect the rights of the patentee against subsequent infringement. Patents, say the Court, in the case of Burr *vs.* Duryee, 9 Wall, 575, had frequently been adjudged invalid, prior to the Patent Act of 1836, from the insufficiency of the specification. The thirteenth section of that act was intended to remedy that evil, by permitting the patentee to surrender his defective patent and have it remedied in proper form, "Whenever it shall be inoperative or invalid by reason of a defective or insufficient description or specification;" but this privilege was not given to the patentee or his assignee in order that the patent may be rendered more elastic or expansive, and therefore more available for the suppression of all other inventions. Power is undoubtedly conferred upon the Commissioner to allow the specification to be amended if the patent is inoperative or invalid for the reason stated in the provision, to reissue the patent in proper form. Pursuant to that authority, he may doubtless allow the patentee to re-describe his invention, and to include in the description and claims of the patent, not only what was well described before, but whatever was suggested or indicated in the specification or drawings which properly belong to the invention. Whether he can be permitted to go further, and resort to the original application and the model filed in the Patent Office, it is not now necessary to decide, as it is conceded that the improvements in question were neither suggested or indicated in the application or model, nor in the specification or drawings. The additions made to the specification were interpolations and not amendments, and consequently the Commissioner had no authority to allow them to be made. Comparing the patents, it is clear on the face of the instrument that the reissued patent is not for the same invention as that secured by the original patent, and therefore it is void.

Having come to this conclusion, it is unnecessary to decide the other questions presented for decision. Complainants are not entitled to relief. Bill of complaint dismissed with costs.

Supreme Court of the United States.

CARHART ET AL. *vs.* AUSTIN.

Reply of the Defendant to the Briefs filed January 13, 1868, *by the Counsel for the Complainants.*

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CARHART ET AL. *vs.* AUSTIN.

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1. The Defendant has propounded and maintained in the argument the proposition *that a re-issued patent cannot contain matter which does not appear in the model, or drawings, or specification filed with the application for the original Letters Patent*, as required by section 6 of the act of Congress of July 4, 1836.

The counsel for the Complainants, in their respective briefs, deny this proposition, and insist upon the contrary; and, in support of their view of the law, they rely on the following cases, viz:

Grant *vs.* Raymond, 6 Peters, 218.
Stimpson *vs.* Westchester Railroad, 4 Howard, 380
Battin *vs.* Taggart, 17 Howard, 74.
Goodyear *vs.* Day, 2 Wallace, Jr., 223.
Hussey *vs.* Bradley, (not reported.)
Woodworth & Wilson *vs.* Brown, (not reported.)

It is submitted that the cases above cited do not in any respect conflict with the principle contended for by the Defendant.

In Grant *vs.* Raymond the re-issue was for the "rotary and revolving motion, with the vibratory and transverse motion," in the mechanism for manufacturing hat bodies. In the original patent the same device was described.

In Stimpson v. The Westchester Railroad, the main question was the admission of secondary testimony to prove the contents of a patent destroyed by the conflagration of the Patent Office. For that purpose the synopsis of the patents published in the Journal of the Franklin Institute, and the oral testimony of Dr. Jones, were admitted. And Dr. Jones expressly testifies that the groove

in the inner rail of Stimpson's mechanism for turning short curves, embraced in the re-issue, was alluded to in the original specification, but was not described so particularly as, in his opinion, it should have been.

In Battin v. Taggart, which was for a machine for breaking and screening coal, the device claimed in the re-issued patent was for "so arranging the rollers that the teeth of one would, in the rotation of the rollers, come opposite the space in the others." This device was described in the original letters patent.

In Goodyear v. Day, sulphur, one of the ingredients used in the compound subjected to the process of vulcanization, was mentioned and described in the specification of the original patent. It is precisely analogous with Battin v. Taggart. The re-issue contained a claim leaving out the use of lead. In Battin v. Taggart the re-issue contained a claim leaving out the screen.

In Hussey v. Bradley, not reported, and which I have not seen, the device covered by the re-issue was found to be represented in the Patent Office model.

And in Woodworth & Wilson v. Brown, also unreported, the facts do not appear. But, according to the statement of one of the complainants' counsel in his brief, [Mr. Keller,] it was demonstrable that, without the pressure rollers, (which were alleged by the defendant not to appear in the original drawings and specification,) the machine could not have worked. Being essential elements in the machine, they undoubtedly appeared in the model deposited in the Patent Office.

But, cases not reported, the facts of which are so loosely stated as in the last two cases, cannot be regarded as very reliable authority.

As before remarked, all the cases above referred to come within the principle contended for by the defendant.

II.

The counsel for the complainants further contend, that if the second and third claims in the reissued patent of August 18, 1857, should be adjudged to be void, the first claim is sufficient, because it covers an independent device with which the two last claims are not connected. And, in support of this point, they rely on the cases of O'Reilly v. Morse, 15 Howard, 120, 121, and Hall v. Miles, 2d Blatchford, 194.

It is submitted that these cases do not sustain the point contended for by the Complainants' counsel.

The eighth claim of the Morse patent covered, and attempted to appropriate, the use of electro-magnetism as a motive power in operating telegraphic machinery. It was simply claiming a power, or principle in nature, without regard to the mechanism by which it was applied. There could not possibly be any description of this power in nature by which persons skilled in the art of constructing telegraphic apparatus could apply it to use, without mechanism of some sort. The claim, therefore, was simply a nullity. Morse had claimed the mechanism, or *modus operandi* by which he applied it, and that was the proper subject of a patent. The claim, therefore, could be stricken out of the specification without in the least respect affecting the description and specification of the other devices claimed.

The Complainants' counsel says the power covered by the eighth claim in the Morse patent was the spirit which pervaded the whole patent. It would be as correct to say that water or steam is the spirit which pervades the mechanism of a mill. And it would be just as absurd to claim water or steam, without the machinery by which it was applied to use, as to claim electro-magnetism, without the mechanism by which that could be subjected and made to contribute to the uses and conveniences of man.

But, in the case at bar, the second and third devices claimed are not so disconnected and distinct from the matter of the first claim, that they could be separated without affecting the latter. They pervade the whole specification. A disclaimer of those two claims would not be a sufficient correction of the patent to make it valid. All the matter which they cover must be eliminated from the specification by a disclaimer, in order to make the patent valid and sufficient in law. And that would take the *reed seats*, which is an element in both of the combinations covered by the second and third claims, from the first claim. The first claim covers "the board which contains the *reed seats*, thus embracing the reed seats as one of the elements of the arrangement. Therefore, the subject matter of the second and third claims cannot be eliminated from the specification without affecting the first claim.

The counsel for the Complainants contend that the subject matter of the first claim in the last re-issue is embraced in

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The counsel for the Complainants contend that the subject matter of the first claim in the last re-issue is embraced in

the first claim of the original patent. That fact is not conceded. In the first patent an improvement in the bellows then deemed of the utmost importance in the structure of the melodeon, was claimed, by which the current of air through the reeds was reversed from a force to a suction current. It now covers a mere *connection* of one thing with another, which is the work of the mechanic and not of the inventor.

But, if the Court should come to the conclusion, that the first claim is sufficiently independent of all other matters as to be able to stand alone, it is contended by the defendant, that the subject matters of the second and third claims were introduced into the new and existing patent, by the wilful default of Carhart, and with intent to mislead and defraud the public. And this fact is proved by the whole history of his conduct in connection with his several patents involved in this case.

Moreover, Carhart has been guilty of unreasonable delay in making his disclaimer. His last re-issue was granted July 18, 1857. This action was commenced July 30, 1862; nearly five years after. During that time, and up to the present, he has had ample time to file his disclaimer of the objectionable matter. He has not yet done it.

Again, the fact of surrender and re-issue the second time, and claiming this very objectionable matter, shows that he never intended to disclaim it. After so long a delay, even if he were the inventor of it, the public have a right to claim it.

III.

The counsel for the complainants have laid much stress on the fact that Carhart, when he brought the instrument to the Patent Office, known in this case as the "Knowles" instrument, he explained to Knowles the reed-cells and concentrating chamber and their functions, which are insisted upon as very important parts of the melodeon. Yet, notwithstanding the importance of those claims, he very soon after goes to his solicitor with the model known in this case as the "Patent Office" model, which does not contain even the most distant hint of those two important devices, and had his specification and claims made out for improvements in the bellows only. That original specification is witnessed, as will be seen by reference to it, by one of the complainants' counsel in this case, who, we may infer, was the solicitor who procured the patent. If Carhart had then

believed that he was the inventor of the devices claimed in the second and third claims of his last re issue, would he not have communicated the fact to his solicitor, and would not that learned and very able gentleman have perceived their importance, and have secured them in the original patent?

These facts throw the mist of doubt over the fidelity of the memories of both Carhart and Knowles touching events and circumstances which transpired twenty years ago.

But, what is of much importance in this case, Carhart, in his deposition, does not affirm that he invented the reed-cells and concentrating chamber.

IV.

The common law and the statutes of the Parliament of England authorize disclaimers and amendments of defective patents. The mode of proceeding is substantially the same as that authorized by our statutes.

Statutes of 5 and 6 William IV, ch. 83, sec. 1.
And 7 and 8 Victoria, ch. 69, sec. 5.

The corrections and amendments are confined to mere slips and clerical errors inadvertently made. The exclusive right could not be extended by the correction of a patent.

Webster on Patents, 17.
Billing & Prince, 112.
Hindmarsh, 206, 209, 210, 211.
Lord Langdale, in Sharp's case, 1 Webster's Rep., 646.

EDMUND BURKE.